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Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

In the Matter
of the
APPLICATION OF FREDERICK C. FOSTER, *Petitioner*

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

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APPLICATION OF FREDERICK C. FOSTER, *Petitioner*

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

Petitioner prays that a writ of certiorari issue to review the decree of the United States Court of Customs and Patent Appeals entered in the above-entitled case on April 15, 1965.

CITATIONS TO OPINIONS BELOW

The opinion of the United States Court of Customs and Patent Appeals (App., pp. 5a-41a) is reported at 343 F.2d 980. Both the original decision of the Patent Office Board of Appeals (App., pp. 65a-70a) dated May 29, 1962 and its decision on reconsideration (App., pp. 71a-73a) dated September 17, 1962 are unreported.

JURISDICTION

The decree of the Court of Customs and Patent Appeals was entered on April 15, 1965 (App., p. 5a). On July 1, 1965 a timely petition for rehearing was denied (App., p. 42a) and the court entered an order staying enforcement of the April 15, 1965 decree until fifteen days from the termination in this Court of any proceedings which may result from this petition (App., p. 42a).

The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTIONS PRESENTED

1. Can the "time-bar" provision of 35 U.S.C. 102(b) properly be extended by construction of the words "described in a printed publication" as used in that statute to deny to an applicant or a patentee the right, guaranteed by 35 U.S.C. 103, to have the question of whether or not the invention is "obvious" determined on the basis of "the subject matter as a whole . . . at the time the invention was made"?

2. Is the Court of Customs and Patent Appeals foreclosed by procedural due process and the statutory limits of its jurisdiction from rejecting an appellant's claim, *sua sponte*, on grounds which the Patent Office never advanced and concerning which the appellant was never notified or given an opportunity to be heard?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves Article I, Section 8, clause 8 of the Constitution (App., p. 1a) and 35 U.S. Code §§ 6, 102(a) and (b), 103, 132, 144 and 282 (App., pp. 1a-4a). It also involves R.S. 4886, as amended (App., p.

4a), which was repealed when the Patent Code of 1952 was passed and was recodified, insofar as pertinent here, in 35 U.S.C. 102(a) and (b).

STATEMENT

The Court of Customs and Patent Appeals, one judge dissenting (App., pp. 28a-41a), has held that the question of whether an invention is "obvious" shall *not* be determined as of "the time the invention was made" as 35 U.S.C. 103 expressly provides.

By "construction of section 102(b)" (App., p. 22a) the court has held that an invention is unpatentable, notwithstanding the provisions of section 103, if the subject matter became obvious more than one year before the applicant filed his application.

This extraordinary result rests on an interpretation of the clause "described in a printed publication" in 35 U.S.C. 102(b) to include references in which the "invention is . . . not described as set forth in section 102" and heretofore cognizable only as evidence of "obviousness" under 35 U.S.C. 103.[1]

This decision expressly reverses the unanimous 1963 decision of the same court in *Application of Palmquist*, 319 F. 2d 547.[2] It destroys any meaningful distinction between sections 102(a) and (b) and section 103 and

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[1] The pertinent portion of section 103 includes, in terms, printed publications *not* cognizable under 35 U.S.C. 102(b).

35 U.S.C. 102(b) is limited to "printed publications" in which the invention is "described."

35 U.S.C. 103 is addressed, *inter alia*, to references including printed publications in which "the invention is not . . . described as set forth in section 102. . . ."

[2] The decision in *Palmquist* was rendered by a four-judge court. Chief Judge Worley did not participate.

hence conflicts directly with the court's many contemporaneous decisions construing these statutes. It presents a superficially facile solution to a number of difficult questions which reach to the very roots of the patent system. And in so doing, it conflicts with many authoritative decisions of this Court.

The decision below is not an isolated instance of a "hard case" making bad law. This is a landmark decision. It has already been followed and reaffirmed in two cases by the court below, *viz., Application of Folkers,* 344 F. 2d 967 (1965) (App., pp. 43a-48a) and *Application of Hassler,* —F. 2d —, decided July 1, 1965 (App., pp. 48a-64a).

The Patent Office considers itself bound by, and is now following, these decisions. The issues involved are raised in virtually every patent application examined by that agency—and in nearly all infringement litigation in the federal courts, including the Court of Claims.[3]

No review is available except in this Court.

The case originated as an appeal under 35 U.S.C. 141 from the refusal of the Patent Office to allow petitioner any claims in his U.S. patent application Serial No. 605,440, filed August 21, 1956.

The subject matter to which the application relates is a new kind of synthetic rubber characterized by exceptional properties not demonstrated by any syn-

[3] Questions involving the interpretation of sections 102(a) and (b) and 103 come before such courts by virtue of the provisions of 35 U.S.C. 282 that patent validity may be challenged "on any ground specified in Part II of this title as a condition for patentability." "Part II" includes sections 102 and 103, both of which are partially captioned "Conditions for Patentability. . ."

thetic rubber known at the time the invention was made. The record shows that the new synthetic rubber could not be made by any previously known procedures.

The court below recognized that petitioner had made an invention. It reversed the Patent Office rejection on certain of the claims in issue but "affirmed" the Patent Office as to others.

The claims with respect to which the rejection was "affirmed" fall in two categories. The first category includes those claims which define products, but recite no method limitations. The second category includes claims, otherwise similar to those of the first category, but which additionally recite certain method limitations that distinguish from the reference as applied. The court below refused, in its original decision and on request for rehearing, to give any consideration whatever to such method limitations. It refused as to both categories of claims to consider the "subject matter as a whole" as expressly required by 35 U.S.C. 103.

The single reference advanced by the Patent Office and considered by the court below was a publication of one Binder.

The court below acknowledged that:

> "Proofs submitted in this case . . . have established that the applicant's invention date was prior to December 26, 1952. The Binder reference is the August 1954 issue of a periodical. It is seen, therefore, that it is *subsequent* to the *date of invention* but more than one year prior to the filing date, which was August 21, 1956. . . ."[4] (App., p. 14a)

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[4] Unless otherwise noted, all emphasis herein is added.

The Patent Office affirmatively recognized that the rejection which the decision below purports to affirm is cognizable under 35 U.S.C. 103—and *only* under 35 U.S.C. 103. It was discussed in the Patent Office Solicitor's brief under the caption, "The rejection under section 103." The opening sentence of the pertinent section of the Solicitor's brief states:

> "The basis of the rejection of the claims predicated on Section 103 is Binder's disclosure A."[5] (S. Br. 15)

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[5] The rejection on Binder affirmed by the Patent Office Board of Appeals was set forth in the Examiner's Answer (R. 199-204) under the heading, "The Rejection." It is reproduced verbatim in the Board's original May 29, 1962 opinion (App., p. 66a). The Examiner lumped *all* of the claims together and "rejected" them "as *unpatentable over* Binder" R. 201, App., p. 66a). The Answer further stated:

> ". . . The Examiner is cognizant that the properties of the polymers defined by the claims differ from those disclosed by the reference; . . . " (R. 201, App., p. 66a)

On this basis, petitioner's contention in the court below was that "The Rejection" was premised upon 35 U.S.C. 103 *alone*. The Solicitor, however, urged in his brief:

> ". . . that different parts of Binder (disclosures A and B) were relied upon as though they were, in fact, two separate references, one part being the basis of a rejection under Section 102, [disclosure B] and another part [disclosure A], under Section 103, . . ." (S. Br. 9)

Under the heading, "The rejection under Section 102," the Solicitor relied upon "disclosure B" as a "full disclosure" (S. Br. 11) of the claimed polymers. "Disclosure B" was urged by the Solicitor to be ". . . a proper *anticipation* under Section 102, . . ." (S. Br. 15) because, he insisted, that disclosure described the subject matter defined by the appealed claims. This "rejection under Section 102" was *reversed* by the court below.

[In this petition "R." refers to the printed record in the court below; "S. Br." designates the Solicitor's Brief in the court below. Both are included in the certified materials transmitted to this Court for use in preparing the record.]

The majority below properly characterized "The rejection under section 103" as involving ". . . *differences* between the claimed subject matter and the reference disclosure which the Patent Office contends would be *obvious* to one of ordinary skill in the art, . . ."[6] (App., p. 15a)

This characterization of the rejection by the court is substantially in the language of 35 U.S.C. 103 on which it was exclusively predicated by the Solicitor. That statute provides in pertinent part:

> "§ 103. Conditions for patentability; *non-obvious subject matter*
>
> "A patent may not be obtained though the *invention is* **not . . . described** *as set forth in section 102 . . . if the* **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole** would have been **obvious** *at the time the invention was made* . . ."

It was petitioner's position below that since Binder, a 1954 publication which did *not describe* the inven-

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[6] 35 U.S.C. 103 requires a consideration of whether "the differences between the subject matter sought to be patented" and the reference "are such that the subject matter *as a whole* would have been obvious . . ." A major fallacy indulged by the Patent Office and perpetuated by the majority below in this case is that consideration was given only to the "obviousness" of the *differences* between Binder's products and those claimed by petitioner. No effort was made to compare petitioner's claimed subject matter *as a whole* with Binder's teachings to determine "obviousness." In particular, both bodies failed to consider that Binder neither discloses nor otherwise suggests a method for preparing products having the attributes of those claimed by petitioner. Note the inconsistent approaches of the same court in the *Riden* case, footnote 9, *infra*, pp. 11-12, and in each of the *LeGrice, Petering, Sheppard* and *Ruschig* cases discussed *infra*, pp. 28-33.

tion, did not exist "at the time the invention was made" in 1952, the rejection was foreclosed by the express language of 35 U.S.C. 103.

Petitioner relied upon the unanimous July 1963 decision of the court below in *Application of Palmquist,* 319 F. 2d 547. The majority recognized that *Palmquist* required a reversal of the Patent Office as to all of petitioner's claims since the "differences in the factual situations" were "of no legal significance." (App., p. 15a)

In *Palmquist,* as in the case at bar, a reference not describing the invention and relied upon to support a rejection under section 103, was shown to have an effective date subsequent to the applicant's invention date but more than one year prior to the time the application was filed.

In *Palmquist,* after review of the relevant authorities, the court held that such a reference was not competent evidence of "obviousness" under 35 U.S.C. 103, since it did not exist "at the time the invention was made" as the statute required. The court said:

> "The position of the examiner, affirmed by the board, is, in effect, that the claims are properly rejected under 35 U.S.C. § 103 if the claimed invention was obvious to one of ordinary skill in the art *at the time the application was filed.*[7] (Emphasis by the court)

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[7] This is the same position taken by the Solicitor in his Petition for Rehearing in *Palmquist.*

In this case, the court in effect held that claims are properly rejected under 35 U.S.C. 103 if the claimed invention was obvious to one skilled in the art a year prior to the time the application was filed, rather than "at the time the invention was made" as expressly required by 35 U.S.C. 103.

"35 U.S.C. § 103 was a *new* provision in the Patent Act of 1952. Its purpose was to take the place of the *case-law* requirement of 'invention' which developed during the preceding century. The *many cases* in which the requirement of 'invention' was stated had an underlying concept, namely, that the presence of 'invention' was to be determined as of the time the invention was made. This concept is now expressed in 35 U.S.C. § 103.

"As stated in In re Rothermel and Waddell, Jr., 276 F. 2d 393, 47 CCPA 866:

> '* * * 35 U.S.C. § 103 is very specific in requiring that a rejection on the grounds the invention "would have been obvious" must be based on a comparison between the prior art and the subject matter as a whole *at the time the invention was made.*' (Emphasis by the court)

See also In re Murray and Peterson, 268 F. 2d 226, 46 CCPA 905. [319 F. 2d at 550]

* * * *

"We think both logic and reason require us to interpret the provisions of 35 U.S.C. § 103 in accordance with *the legal principles which preceded* and are *codified* in it. The *principles established before 1952* required that the time as of which the determination of 'invention' was to be made was 'the time the invention was made.' They apply equally to the determination of obviousness under 35 U.S.C. § 103." [319 F. 2d at 551]

The opinion of the majority below after an "unusually long time" in "gestating" expressly overruled *Palmquist.*[8]

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[8] The quotations are from the concurring opinion below of Judge Rich (App., p. 28a). The case was argued below on February 11, 1964. The decision was not rendered until April 15, 1965. A Petition for Rehearing filed by the Patent Office in *Palmquist* was summarily denied on January 17, 1964.

"Because of the importance of the question to the law of patents, . . ." the majority below, *sua sponte,*

> ". . . deemed it desirable to reconsider what is the statutory basis of this 'unpatentable over' or obviousness type of rejection, such as we have here and had before us in Palmquist, . . ." (App., pp. 15a-16a)

As a result of such reconsideration, the majority rejected the construction of 35 U.S.C. 103 urged by the Solicitor. It recognized that "The rejection under section 103" could not be sustained by any tenable "construction" in view of the express mandate of that statute that the issue of obviousness be determined "at the time the invention was made."

For this reason, the majority disclaimed any reliance on 35 U.S.C. 103, the only statute which in terms relates to obviousness. Instead, the majority asserts its decision "is predicated on our construction of 35 U.S.C. 102(b)."

Section 102(b) is not concerned with obviousness at all. It is limited in terms to "printed publications" in which the invention is "described."

Section 103 is exclusively concerned with obviousness. Section 103, by its express terms, extends to the very references *excluded* by section 102(b). It specifically contemplates printed publications in which the "invention is not . . . described as set forth in section 102. . . ." It requires for patentability that the "differences" between "the invention as a whole" and printed publications, such as the Binder publication in this case, in which the invention is *"not . . . described"* be unobvious to a person of ordinary skill in the art "at the *time* the invention was made."

As a prerequisite to predicating its decision on 35 U.S.C. 102(b), the majority framed an entirely *new* issue which it then decided. Disregarding the express language of both the relevant statutes—and the statutory limits on its jurisdiction as well—that *new* issue, as stated by the majority, was

> "... whether there was a loss of right to a patent, i.e., whether the invention became obvious to the public at the time of the Binder publication. ..." (App., p. 23a)

—a date more than one year before the petitioner's filing date.

Nor was the majority content to deny petitioner the right to have the question of "obviousness" determined "at the time the invention was made." By shifting the basis of rejection from section 103 to section 102(b), the majority sidestepped the further requirement of section 103 that obviousness is to be judged in light of "the subject matter as a whole." Instead, the court considered the "differences" between Binder's teachings and the subject matter claimed by Foster in light of mere "mechanistic overlaying" of similarities,[9] and

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[9] The quotation is from the opinion of the court below in *Application of Riden*, 318 F.2d 761 (1963). In that case the court stated:

> "As to the method of making the compounds claimed being different from Boehme et al., we agree with appellants that this fact is relevant. Chemical cases should not be decided solely on the basis of homology or analogy in structural formulae. *The determination of obviousness is not the mechanistic overlaying of chemical formulae. ...*" [318 F.2d at 764]

The court below has repeatedly condemned the "mechanistic" rejection of chemical compound inventions for "obviousness", recognizing that such treatment denies consideration to "the subject matter as a whole." See, *inter alia*, *Application of Lunsford*,

in total disregard of "the subject matter as a whole." In particular, the majority refused both in its original decision (App., p. 26a) and on request for reconsideration (App., p. 42a) even to consider the failure of the reference to disclose or suggest any process for preparing petitioner's claimed products—a deficiency emphasized by the method limitations which are part of the description of the invention in the category 2 claims.

Thus, the majority "affirmed" a new rejection of its own creation—a rejection which the Patent Office had never made and concerning which appellant below, petitioner here, had never been notified or given an opportunity to be heard.[10]

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327 F.2d 526 (1964), and *Application of Ward*, 329 F.2d 1021 (1964).

The position of the majority below is wholly inconsistent with its previous condemnations of this "mechanistic" approach to "obviousness" of chemical compounds. Moreover, it is irreconcilable with the *reaffirmation*, one week after the decision below, of the *Riden, Lunsford* and *Ward* cases in *Application of Ruschig*, discussed *infra*, pp. 32-33. The result is manifest uncertainty as to the criteria to be applied in determining "obviousness" of chemical compounds.

[10] The same maneuver was executed by the majority for precisely the same purpose in *Application of Folkers*, 344 F.2d 967, decided by the court below on May 20, 1965. In Judge Smith's dissent in *Folkers* he pointedly observed:

> "To me it is unconscionable that an applicant can now receive a rejection from the Patent Office on one statutory ground, and then, on appeal from that rejection, receive a wholly new rejection from this court which is based on an entirely *different* statutory ground. I would reverse." (App., p. 48a) [344 F.2d at 970]

The respective positions of the parties in this case concerning the *nature* of the Patent Office rejection as "unpatentable over"

REASONS FOR GRANTING THE WRIT

Succinctly stated, this petition should be granted because:

(a) The questions presented are fundamental to the Court's elucidation, this term, of the conditions for patentability defined in 35 U.S.C. 102 and 35 U.S.C. 103.

(b) The decision below is premised on an interpretation of R.S. 4886 which is totally inconsistent with the controlling decisions of this Court as understood by Congress at the time the 1952 Act was passed.

(c) The decision below, in violation of the relevant principles of statutory construction enunciated by this Court, destroys any meaningful distinction between sections 102(a) and (b) and section 103.

Binder are discussed in footnote 5, *supra,* p. 6. After considering these respective contentions, the court below held:

> "We agree that the language employed is confusing and that it is not clear what section of the statute is intended. On the other hand, we are not convinced that there is any 'magic' to the particular words used or that they can only mean reliance on section 103. The words 'unpatentable over' do not *necessarily* mean reliance on section 102 *alone.* The statements of the rejections are sufficient for us to consider the rejections on both sections 102(b) and 103." (Emphasis by the court) (App., p. 11a)

Absent any foundation in the position of either party, the court thus employed the Solicitor's reliance upon section 102(b) as to Binder's "disclosure *B*" as a bootstrap for "sustaining" a section 102(b) rejection on Binder's "disclosure *A*". But the Patent Office never made such a rejection and the Solicitor never contended that it did. The Solicitor's sole contention as to the rejection on "disclosure *A*" was that it was "predicated on section 103."

(d) To the extent that the decision below merges "obviousness" with "anticipation", it conflicts with many decisions of this Court and the federal courts of appeals.

(e) The decision below is in direct conflict with the decisions of this Court construing the "time-bar" provisions of the patent statutes.

(f) The recent decisions of the Court of Customs and Patent Appeals interpreting 35 U.S.C. 102 and 35 U.S.C. 103 are in irreconcilable conflict.

(g) The majority opinion violates procedural due process and exceeds the jurisdiction of the court as limited by 35 U.S.C. 144.

DETAILED STATEMENT OF REASONS FOR GRANTING THE WRIT

1. The Questions Presented Are Fundamental to the Court's Elucidation, This Term, of the Conditions For Patentability Defined in 35 U.S.C. 102 and 35 U.S.C. 103.

For its initial consideration of the prerequisites to patentability defined in the Patent Act of 1952, the Court has selected six cases [11] to be decided this term.

The apparent objective of the Court in accepting these six cases is to provide authoritative guidelines by which the issues of patentability and validity may be determined in the Patent Office and the federal courts.

Resolution of the fundamental questions presented by this petition is an essential prerequisite to the realization of that objective. Informed disposition of five of the pending cases will necessarily depend on this Court's evaluation of the dominating issues presented by this case.

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[11] Nos. 11, 37, 43, 55, 57 and 58.

Four of these pending cases [12] seek an interpretation, in relation to particular "inventions", of the word "obvious" as that word is used in 35 U.S.C. 103. Such interpretation by this Court will necessarily involve an elucidation of the permissible scope of the statutory standard of patentability under the constitutional patent clause. Fundamental to any decision in these cases is a determination of whether the majority below was right or wrong in holding that § 102(b) requires "obviousness" to be determined *not* in light of "the subject matter as a whole . . . at the time the invention was made," as § 103 provides, but, rather, as of one year prior to the patentee's filing date.

To date, briefs on the merits have been filed in only one [13] of these four obviousness cases. In addition to the brief of the petitioners, five briefs *amicus curiae* have been presented. These briefs uniformly urge that Congress, by the enactment of 35 U.S.C. 103, intended to define a standard of patentability lower than that which this Court, prior to 1952, consistently found necessary to an implementation of the requirements of the Constitution. All six briefs are premised in major part upon a "construction" of 35 U.S.C. 103 rested upon the text and the immediate pre-1952 legislative history of that act. That "construction" would result in a "standard of patentability" substantively indistinguishable from the requisites for "novelty" under sections 102(a) and (b) and their predecessor statutes. A dominant theme of all the briefs is that the constitutional mandate "to promote progress in science and the useful arts" is satisfied *even if no advance—or one*

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[12] Nos. 11, 37, 43 and 55.

[13] No. 11.

barely perceptible—is made, providing the patented "contribution" is novel and commercially successful. Thus, these four presently pending cases inherently raise, but avoid directly placing in issue, the relationship, if any, between section 103 and sections 102(a) and (b).

The limited question in No. 57 is whether a "copending patent"—i.e., one issued after the filing date of the application or patent against which it is cited, but filed prior thereto—which is maintained in secrecy in the Patent Office until it issues is admissible under 35 U.S.C. 103 to show the capabilities of a person of ordinary skill in the art.

The case for the petitioner apparently will rest on a "construction" of section 103 in light of section 102 finding alleged support in the legislative history of both acts.

Plenary consideration by this Court of the entirety of both sections 102 and 103, including particularly the paramount issues presented only by this petition, is manifestly essential to a full delineation this term of the guidelines by which patentability and patent validity are to be judged.

2. The Decision Below Is Premised On An Interpretation Of R.S. 4886 Which Is Totally Inconsistent With The Controlling Decisions Of This Court As Understood By Congress At The Time The 1952 Act Was Passed.

The majority opinion below is affirmatively predicated on "our construction of section 102(b). . . ." (App., p. 22a)

Section 102(b) recodified, without change, a portion of R.S. 4886. The Reviser's Note states:

> "Paragraphs (a), (b), and (c) are based on . . . R.S. 4886 . . .

> "No change is made in these paragraphs other than that due to division into lettered paragraphs. . . ."

The Reviser's Note is foursquare with Senate Report No. 1979 [14] which accompanied the bill adopted as the Patent Act of 1952. That report states:

> "Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty." [Senate Report No. 1979, p. 5.]

The majority below necessarily agreed with the Patent Office Solicitor that the rejection was cognizable only under section 103. Absent such agreement, there would have been no point to overruling *Palmquist*. In light of this and the further circumstance that section 102(b) merely recodified R.S. 4886, the majority below was impelled to find, *as the very crux of its opinion,* that R.S. 4886 had always contemplated the same "obviousness" situations now expressly cognizable under 35 U.S.C. 103.

To that end, the majority below held:

> ". . . Under the old law (R.S. 4886, where 102(b) finds its origin) patents were refused or invalidated on references dated more than a year before the filing date because the invention was anticipated or, if they were not then *because there was no 'invention,'* . . . [Emphasis by the court] There was no need to seek out *the precise* **statutory** *basis because it was R.S. 4886 in any event,* read in the light of the Supreme Court's interpretation of the law that there must always be 'invention'. . . ." (App., p. 19a)

Thus, to achieve its objective, the majority conveniently ignored what it had affirmatively recognized in

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[14] Senate Report No. 1979, June 27, 1952, 82nd Congress, Second Session.

Palmquist, namely, that "the Supreme Court's interpretation of the law" *here* relevant recognizes that the prior statute, R.S. 4886, like section 102(b), is limited *in terms* to "printed publications" which "describe" the invention claimed.

Moreover, this crucial determination—that the substance of section 103 was included in R.S. 4886—is inconsistent on its face with the majority's subsequent recognition that section 103 is a *new* statute codifying *decisional* law. In its sole reference to the relevant legislative history, the majority acknowledged:

> "... Its legislative history, which is well known and uncomplicated, shows that section 103 had but a single purpose which was *to add to the statute a provision* to take the place of the *judge-made 'requirement for invention'....*" [15] (App., p. 22a)

This statement conforms identically to Congressional understanding of the controlling decisions of this Court at the time the 1952 Act was passed. Senate Report 1979, on which the majority obviously relied, states:

> "... The *major changes* or innovations in the title consist of *incorporating* a *requirement for invention* in § 103 and the judicial doctrine of contributory infringement in § 271. [Senate Report No. 1979, p. 4]

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[15] In *Application of Papesch,* 315 F.2d 381, 386 (1963), a unanimous court composed of the same five judges who participated in the decision below, stated:

> "As everyone knows, section 103 is the statutory version of what was, prior to January 1, 1953, the effective date of the latest revision of the patent statutes, the judge-made requirement of 'invention.' "

> "Section 103, for *the first time in our statute,* provides a condition which exists in the law and has existed for more than 100 years, *but only by reason of decisions of the courts. . . .*" [Senate Report No. 1979, p. 6]

The "requirement for invention" codified in 35 U.S.C. 103, to which both the majority and the Committee Report advert, was "judge-made" for the very reason that R.S. 4886 did *not* contemplate "obviousness situations" as the majority now affirmatively holds.

The inescapable fact that the constitutionally premised "standard of patentability" now codified in section 103 was never included in R.S. 4886, or in the recodification of that statute without change in section 102(b), is demonstrated by any objective evaluation of the relevant precedent.

The Reviser's Note to section 103 asserts that "the holding of patents invalid by the courts on the ground of lack of invention . . . has been followed since at least as early as 1850"—an obvious reference to the decision sustaining the nonstatutory defense of lack of invention in *Hotchkiss et al* v. *Greenwood et al,* 52 U.S. (11 How.) 248, 13 L. Ed. 683 (1850).

Another pertinent decision of this Court is *Mahn* v. *Harwood,* 112 U.S. 354, 358, 28 L. Ed. 665, 667, 5 S.Ct. 174 (1884), which states:

> ". . . But the statutory defenses are not the only defenses which may be made against a patent. Where it is evident that the Commissioner, under a misconception of the law, has exceeded his authority in granting or re-issuing a patent, there is no sound principle to prevent a party, sued for its

infringement, from availing himself of the illegality, independently of any statutory permission so to do.

* * * *

"In cases of patents for inventions, *a valid defense not given by the statute often arises where the question is, whether the thing patented amounts to a patentable invention.* This being a question of law, the courts are not bound by the decision of the Commissioner, although he must necessarily pass upon it. . . ."

The majority below, ignoring this and other relevant decisions of this Court, supported its finding that R.S. 4886 contemplated "obviousness situations" by reference to Patent Office Rule 131 and its predecessor, Rule 75 (App. 16a-20a). It, accordingly, found that section 103 is governed by a mere Patent Office rule, despite the clear requirement of 35 U.S.C. 6 that Patent Office rules shall be "not inconsistent with law." Thus, the majority below has vested in the Patent Office an authority greater than that of Congress to determine what statutes shall say.

Only this Court can review the propriety of this situation. The court below and the Patent Office are caught in an endless cycle wherein the Patent Office is bound by the decisions of the Court of Customs and Patent Appeals and such court looks, in interpreting the law, to the rules of the Patent Office for guidance. Until this Court takes affirmative action, there is little likelihood that the law as enacted by Congress can or will be followed by either body.

3. The Decision Below, In Violation of the Relevant Principles of Statutory Construction Enunciated By This Court, Destroys Any Meaningful Distinction Between Sections 102(a) and (b) and Section 103.

Without challenge from the majority or from either of the separate concurring opinions, dissenting Judge Smith states:

> ". . . Today's decision destroys any meaningful differences that may have existed in the past between sections 102(a) and (b) and section 103. . . ." (App., p. 38a)

By this ruling, section 103—a "new section" constituting one of only two "major changes or innovations" effected by the 1952 Act—is reduced to a reiteration of section 102(a) which, together with sections 102(b) and (c) merely "repeats the conditions in the existing law relating to novelty".[16]

This conclusion is compelled even by a casual examination of the statute.

The word "described" must have the same meaning in both sections 102(a) and (b) since both sections spring from and recodify the *single* occurrence of that word in R.S. 4886.

Adopting the majority "construction" of the word "described" section 102(a) would provide that a patent shall not be granted if

> "the invention was . . . described in a printed publication . . . *or became obvious* . . . before the invention thereof by the applicant. . . ."

So construed, section 102(a) is the *same* statute as section 103 because the words "at the time the inven-

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[16] The quotation is from Senate Report No. 1979, footnote 14, *supra*, p. 17, at p. 5 thereof.

tion was made" in the latter section are identical in meaning with the words "before the invention thereof by the applicant" in the former.

This result, which renders section 103 a mere redundancy in view of section 102(a), violates the controlling principles of statutory construction enunciated by this Court.

In *Jarecki* v. *Searle & Co.*, 367 U.S. 303, 307, 308, 6 L.Ed. 2d 859, 863, 81 S.Ct. 1579 (1961), this Court said:

> "... The statute admits a reasonable construction which gives effect to all of its provisions. In these circumstances we will not adopt a strained reading which renders one part a mere redundancy. See, e.g., United States v. Menasche, 348 U.S. 528, 538, 539, 99 L ed 615, 623, 624, 75 S Ct 513."

In *Menasche,* this Court in interpreting two separate sections of the Nationality Act of 1940, held:

> "The Government's contentions that § 405(a) does not apply to any phase in the processing of naturalization petitions would defeat and destroy the plain meaning of that section. *'The cardinal principle of statutory construction is to save and not to destroy.'* N.L.R.B. v. Jones & L. Steel Corp. 301 US 1, 30, 81 L ed 893, 907, 57 S Ct 615, 108 ALR 1352. It is our duty 'to give effect, if possible, to every clause and word of a statute,' Montclair v. Ramsdell, 107 US 147, 152, 27 L ed 431, 433, 2 S Ct 391; rather than to emasculate an entire section, as the Government's interpretation requires." [348 U.S. 528, 538, 539, 99 L. Ed. 615, 624, 75 S. Ct. 513 (1955)]

By its amalgamation of the two statutes, contrary to these established principles of construction, the major-

ity below has placed itself in direct conflict with the Court of Appeals for the Eighth Circuit. *That* court, in rejecting a contention that the provisions of section 102(b) should be read in light of section 103, held:

> "The legislative history of the 1952 revision of the Patent laws (Title 35 U.S.C., 1946 Ed.) refutes the contention that § 103 was intended to modify or affect in any way § 102(b). . . ." [Bros Inc. v. Browning Mfg. Co., 317 F. 2d 413, 417 (8 Cir. 1963)]

4. To The Extent That The Decision Below Merges "Obviousness" With "Anticipation", It Conflicts With Many Decisions Of This Court And The Federal Courts of Appeals.

The majority below alleged:

> "It would seem that the practical operation of the prior law was that references having effective dates more than a year before applicant's filing date were always considered to be effective as references, regardless of the applicant's date of invention, and that rejections were then predicated thereon for 'lack of invention' without making the distinction which we now seem to see as implicit in sections 102 and 103, 'anticipation' or no novelty situations under 102 and 'obviousness' situations under 103. . . ." (App., p. 21a)

This statement of the majority is contrary in two respects to "practical operation of the prior law" in this Court and the federal courts of appeals. It is also contrary to "practical operation" of the *present* Patent Act in the courts of appeals. Firstly, a clear line of demarcation *has* been maintained between "obviousness"—i.e., "lack of invention"—and "anticipation" —i.e., "lack of novelty"—as grounds for invalidating patents. Secondly, it has been recognized that the references applicable on the first ground are those extant at the *invention date.*

The autonomy between "obviousness" and "anticipation" recognized by this Court prior to 1952 is illustrated in *Carbice Corp. of America* v. *American Patents Dev. Corp.*, 283 U.S. 420, 75 L.Ed. 1153, 51 S.Ct. 496 (1931). In that case this Court held a patent invalid on both of those two grounds, advancing separate and distinct reasons in support of each ground.

Since the 1952 Patent Act the federal courts of appeals have continued to recognize that "obviousness" under section 103 and "anticipation" under section 102 are independent grounds for invalidation of a patent. Exemplary of this recognition are the 1956 opinion of the Court of Appeals for the Second Circuit in *Helene Curtis Industries* v. *Sales Affiliates*, 233 F. 2d 148, and that portion of the opinion in *McCullough Tool Company* v. *Well Surveys, Inc.*, 343 F. 2d 381 (10 Cir. 1965), which is devoted to consideration of the validity of the Pringle patent.

In *Helene Curtis* the court discussed these separate grounds for invalidation under the respective headings "lack of invention" and "anticipation." Preliminary to both discussions, the court affirmatively recognized that the question of "lack of invention" must be decided on the references existing at the invention date. The court stated:

> "The question of patentable invention depends upon the prior art existing at the invention date of the patent in suit. Consequently, we will preface our discussion of the problem as to invention by an examination of the holding made below that McDonough was not entitled to a preapplication invention date." [233 F. 2d at 155]

This recognition of the need for establishing the invention date as a prerequisite to determining what

evidence may be considered on the issue of "obviousness" is in accord with the pre-1953 practice in this Court. As this Court implicitly recognized, that practice was compelled by the fact that R.S. 4886 contained no directions for determining "obviousness," coupled with the public policy which requires that "time-bars" on statutory rights be strictly confined to the scope defined by Congress.[17]

Exemplary of such recognition is this Court's opinion in *Concrete Appliance Co.* v. *Gomery,* 269 U.S. 177, 180, 70 L.Ed. 222, 225, 46 S.Ct. 42 (1925), wherein the Court observed:

> ". . . the difference in result reached by the two circuit courts [below] leads us to review the salient features of the state of the art at about January 1908, when, according to petitioners, Callahan conceived the combination covered by the claims in his patent."

"Obviousness" was similarly determined on the basis of the state of the art at the invention date in each of the following opinions of this Court: *Electric Cable Joint Co.* v. *Brooklyn Edison Co.,* 292 U.S. 69, 78 L. Ed. 1131, 54 S.Ct. 586 (1934); *Paramount Publix Corp.* v. *American Tri-Ergon Corp.,* 294 U.S. 464, 79 L.Ed. 997, 55 S.Ct. 449 (1935); *Textile Mach. Works* v. *Louis Hirsch Textile Machines,* 302 U.S. 490, 82 L. Ed. 382, 58 S.Ct. 291 (1938), *affirming* 87 F. 2d 702 (2 Cir. 1937); and *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350, 83 L.Ed. 1334, 59 S.Ct. 897 (1939).

Far from proceeding "regardless of the applicant's date of invention," this Court always considered it

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[17] See the discussion of petitioner's reason 5, pp. 26-28, *infra.*

necessary to establish that date of invention before deciding what evidence could be considered in evaluating "obviousness." The majority below appears to have been alone in holding otherwise.

5. The Decision Below Is In Direct Conflict With The Decisions Of This Court Construing The "Time-Bar" Provisions Of The Patent Statutes.

The majority below acknowledged that its decision is based upon its own notions of what "Congress could not possibly have intended" (App., p. 22a) rather than the express language of *either* 35 U.S.C. 103 or 35 U.S.C. 102(b). Professing to find "a paucity of direct precedents on the precise problem" (App., p. 19a), it felt free to ignore the clear words of these statutes in favor of a nonexistent "public policy" of its own creation.

Attempts, purportedly justified on "policy" grounds, to change the scope of "time bars" of the patent laws are no novelty. Since at least 1896 this Court has consistently rebuffed such attempts and held to be paramount that policy which requires such "time bars" to be construed in strict conformity with the declarations of Congress.

By 35 U.S.C. 103 Congress guaranteed petitioner the *right* to have the question of obviousness determined in light of "the subject matter as a whole . . . at the time the invention was made". By "interpretation" of 35 U.S.C. 102(b) the decision below denies petitioner that statutory right—and clashes head-on with the repeated rulings of this Court that "a party seeking a right under the patent statutes may avail himself of all their provisions and the courts may not deny him the benefit of a single one." *Overland Motor Co.* v. *Packard Motor Car Co.*, 274 U.S. 417, 71 L.Ed.

1131, 47 S.Ct. 672 (1927); *Chapman* v. *Wintroath,* 252 U.S. 126, 64 L.Ed. 491, 40 S.Ct. 234 (1920); *United States* v. *American Bell Tel. Co.,* 167 U.S. 224, 42 L. Ed. 144, 17 S.Ct. 809 (1897).

In *Chapman,* in holding the "time bar" of R.S. 4886 to be bounded by the precise declaration of Congress, this Court stated:

> "There is no suggestion in the record that the original application of the Chapmans was not prosecuted strictly as required by the statutes and the rules of the Patent Office, and therefore, it is settled, their rights may not be denied or diminished on the ground that such delay may have been prejudicial to either public or private interests. 'A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that, in its judgment, they were unwise or prejudicial to the interests of the public.' United States v. American Bell Teleph. Co. 167 U.S. 224, 246, 42 L. ed. 144, 155, 17 Sup. Ct. Rep. 809." [252 U.S. at 136, 137; 64 L.Ed. at 495]

The principles enunciated in *Chapman* and *Bell* were reiterated verbatim in rejecting analogous arguments in *Overland.*

Cognizant of the principles enunciated in *Chapman, Overland* and *Bell,* the dissenting judge quite understandably complains:

> *"Even if there were such a pervasive policy, it is an usurpation of the legislative function for this*

court to rewrite the statute. . . ." (Emphasis in original) [18] (App., p. 33a)

6. The Recent Decisions Of The Court Of Customs And Patent Appeals Interpreting 35 U.S.C. 102 and 35 U.S.C. 103 Are In Irreconcilable Conflict.

Illustrative of the conflict are some eight decisions [19] which the court below has rendered since April of 1962 interpreting 35 U.S.C. 102(b) and 35 U.S.C. 103. Five of these decisions [20]—two decided in the spring of 1962, one decided in December 1964, and two decided in April and May of this year—hold that there is a *limitation* on the availability of disclosures in printed publications as time-bars under 35 U.S.C. 102(b), by which such references are distinguished from the larger class of printed publications competent to show obviousness under 35 U.S.C. 103.

Three decisions, of which this case is one,[21]—all rendered this year—hold precisely the contrary.

On May 13, 1965, in *Application of Folkers,* 344 F. 2d 967 (App., pp. 43a-48a), the decision below was reaffirmed and its major principles reiterated in the following language:

> "Whatever right to a patent appellant may have had at the time the invention was made, it has been lost within the meaning of section 102(b) *if,* indeed, the claimed invention *became* obvious to one

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[18] As the dissenting judge demonstrates, there is, of course, no such pervasive policy. (App., pp. 28a-33a)

[19] In addition to *Palmquist,* 319 F.2d 547, overruled in this case.

[20] *Viz.,* the opinions in the *LeGrice, Ruschig, Sheppard, Petering* and *Hughes* cases. [Citations in text, infra, p. 29]

[21] The others are that of the majority in *Folkers* and the *Hassler* decision.

> of ordinary skill in this art through the publication of the reference more than one year before appellant filed his application." (Emphasis by the court) (App., p. 44a) [344 F. 2d at 968]

The decision in this case was again followed and reaffirmed on July 1, 1965 in *Application of Hassler,* — F. 2d — (App., pp. 49a-64a).

In the decision below and in *Folkers* and *Hassler* the court affirmatively held that there is *no distinction* to be drawn between printed publications competent to show that an invention is "described" under 35 U.S.C. 102(b) and those competent under 35 U.S.C. 103 to show that the invention is "obvious."

To reach this remarkable result in the first instance, the majority below ignored its own earlier inconsistent interpretations of the same statutes in *Application of LeGrice,* 301 F. 2d 929 (1962); *Application of Petering,* 301 F. 2d 676 (1962); and *Application of Sheppard,* 339 F. 2d 238 (1964). One week later, in *Application of Ruschig,* 343 F. 2d 965, decided April 22, 1965, the court below veered back to its pre-*Foster* interpretation of those statutes. A scant three weeks after that, the majority in *Folkers* reaffirmed *Foster* and, thus tacitly and temporarily disavowed, without overruling, its prior inconsistent interpretations, including *Ruschig.* By the next week, however, the court below had again re-evaluated these statutes, and in *Application of Hughes,* 345 F. 2d 184, it moved back in the direction of *LeGrice, Petering, Sheppard* and *Ruschig.* Five weeks later, on July 1, 1965, the majority below handed down its opinion in *Hassler.* It disdained the opportunity[22] to salvage some semblance of autonomy

[22] See Judge Smith's separate concurring opinion in Hassler (App., pp. 62a-64a) and the discussion, *infra,* p. 34, concerning it.

in the separate statutory sections and premised its holding upon the majority opinion in this case, without regard to any of *LeGrice, Petering, Sheppard, Ruschig* or *Hughes.*

In *LeGrice,* one of the earliest of these eight cases, the court in 1962 rendered a unanimous, definitive 15-page opinion construing the expression "described in a printed publication" as used in section 102(b). It affirmatively held that there was a strict *limitation* upon the availability of disclosure in printed publications as bars under section 102(b).

LeGrice involved an application for a plant patent. The reference was a printed description of the plant. The record established that those skilled in the art could not reproduce the plant from the printed description. The court held that the reference did not "describe" the invention within the meaning of 35 U.S.C. 102(b). It stated:

> ". . . When used in the Patent Act of 1952, this clause had acquired in the context in which it is used in section 102(b) something other than an 'exact and unequivocal meaning' as a result of the *judicially imposed limitation* that this clause requires that the description of the invention in the printed publication *must be an 'enabling' description. . . .*" [301 F. 2d at 939]

The court made it clear that by an "enabling" description it meant a description which was "practical and complete" which made the invention available to those skilled in the art "as a practically operative means."

The court went on to overrule, qualify, or distinguish other decisions relied upon by the Patent Office as authority that printed publications which merely name

chemical compounds, but do not teach how such compounds could be prepared, are "printed publications" within the meaning of section 102(b). In holding that such references were not "enabling," the court in *LeGrice,* stated:

> ". . . Even in the chemical art, however, where the knowledge of skilled artisans is great, there are *limitations* on the availability of disclosures in printed publications as bars under section 102(b)." [301 F. 2d at 943]

In the 1964 *Sheppard* case, a *chemical case,* the court unanimously extended its ruling in *LeGrice* to section 102(a).

In *Petering* in 1962 the court applied the very *limitation* upon availability of printed publications as bars under section 102(b) which it affirmatively elucidated in its substantially contemporaneous decision in *LeGrice.*

Petering involved a rejection of a group of claims on a *single* reference, namely, a patent to one Karrer.

After consideration of the reference and the requirements of 35 U.S.C. 102(b), including the limitation upon disclosures in printed publications available as bars under that section, it divided the rejected claims in two groups.

With respect to a *first* group of claims, it held that the reference "described" the claimed invention within the meaning of 35 U.S.C. 102(b) and hence was *not* excluded by the limitations of that section because:

> ". . . Karrer has described to those with ordinary skill in this art each of the various premutations [sic] here involved as fully as if he had drawn each structural formula or had written each name. . . . For these reasons, we hold that each compound

> within the limited class in Karrer, . . . has been *described* in a printed publication within the meaning of 35 U.S.C. § 102(b), . . ." (Emphasis by the court) [301 F. 2d at 682]

The court then considered and reversed *both* the section 102 and the section 103 rejections of the *second* group of claims. In so doing, the court carefully defined the distinction which it *then* recognized—but later denied in this case and *Folkers* and *Hassler*—between the *limited* group of printed publications cognizable under 35 U.S.C. 102(b) and the much *broader* group contemplated by 35 U.S.C. 103. It said:

> "Next we consider claims 5, 11 and 12. The compounds encompassed by these claims, reciting as all of them do an ethyl group, C_2H_5, at the 6-position or ethyl groups at the 6- and 7-positions, are not included in the limited class which we find in Karrer. *Therefore, it is our opinion that these compounds have not been described by Karrer within the meaning of 35 U.S.C. § 102(b) and we turn to the question of their obviousness under 35 U.S.C. § 103. . . .*" (Emphasis by the court on the word "described" only) [301 F. 2d at 682, 683]

On April 22, 1965, one week *after* the decision below—but prior to both *Folkers* and *Hassler*—the court considered the *Application of Ruschig,* 343 F. 2d 965. In *Ruschig,* the court ignored this case to follow *Petering.*

In *Ruschig,* the court concluded that there had been a rejection by the Patent Office of all of the claims on the same references under *both* sections 102 and 103, just as there had been in *Petering.* The court asserted:

> "In this situation we have two different issues to deal with, anticipation under section 102 and

> obviousness under section 103. To keep matters clear, we shall deal with them separately." [343 F. 2d at 972]

It then proceeded to "separately" decide these "two different issues" under separate headings in its opinion. Under the heading, "The Board's Own Anticipation Rejection" the court emphasized the very same *limitations* on references available under section 102(b) which it had previously stressed in *Petering* and affirmed in principle in *LeGrice*. It concluded that the references relied upon by the Patent Office were excluded by the limitations of section 102(b) and reversed the "anticipation" rejection under section 102 (b). It then discussed the very *same* reference as applied to the *same* claims under the heading "The Obviousness Rejection". It recognized the very distinction—denied below and in *Folkers* and *Hassler*, but emphasized in *Petering*, *LeGrice* and *Sheppard*—between printed publications competent as "bars" under section 102(b) and those competent only on the issue of "obviousness" under section 103.

Thereafter in *Application of Hughes*, 345 F. 2d 184, the court again affirmatively *acknowledged* what it expressly denied below and in *Folkers* and *Hassler*, namely, the material difference between references available under sections 102 and 103.

Is there, or is there not, a distinction between section 102(b) references and section 103 references and, if so, what is it?

The situation comes full circle in *Hassler*—the court's latest expression on the point. In that case, unlike *Foster* or *Folkers*, the invention—an apparatus—was contended to have been disclosed by the

appellant himself in a newspaper article more than one year before his filing date. Because certain claimed structural details were not precisely disclosed in the article, a question arose concerning whether the rejection before the court was a rejection under section 102 or section 103. The majority did not decide under which section of the statute the rejection had been made, but simply held, citing *Foster,* that the article is "a valid reference under 35 U.S.C. 102(b) *for what is disclosed therein.*" (Emphasis by the Court) (App., p. 51a)

Judge Smith, in his separate concurring opinion, asserted that the result was governed, *inter alia,* by *Sheppard* and *LeGrice* because "the invention was *described* in the printed publication." (App., p. 63a) He further stated:

> "To the extent the resolution of the issue here requires a determination of patentability under section 103, as the majority seems to indicate, I would *reverse* for the reasons more fully elaborated in my dissenting opinion in In re Foster, 52 CCPA —, — F. 2d —, 145 USPQ 166. However, it does not seem to me that this issue is here presented since the publication relied upon 'describes' the claimed invention within the meaning of section 102(b) and the many decisions which have interpreted it. I therefore concur in the result reached but do so solely on this basis." (Emphasis in original) (App., p. 64a)

The hopeless confusion of the court below is grossly prejudicial to the functioning of the patent system. It can be dispelled only by an authoritative decision of this Court.

7. The Majority Opinion Violates Procedural Due Process and Exceeds the Jurisdiction of the Court as Limited by 35 U.S.C. 144.

The uncertainty of the court below concerning the meaning of 35 U.S.C. 102 and 103 has led to grave problems of procedural due process. Consequent from this uncertainty, the Patent Office practice of rejecting claims as "unpatentable over" one or more references has failed to discharge the duty of that Office under 35 U.S.C. 132 to apprise applicants of the precise grounds, statutory and otherwise, for rejection.

The court below, in its turn, has used the ambiguous expression "unpatentable over" to "affirm" the Patent Office upon rejections actually advanced by the court and *never* made by the Patent Office, even as it has done in this case.

It has been demonstrated that the majority below discarded the Patent Office Solicitor's "rejection under section 103" and substituted its own rejection "predicated" on its "construction of 35 U.S.C. 102(b)" (App., p. 22a). It purported to justify this maneuver by its "interpretation" of the words "unpatentable over" employed by both the Examiner and the Board of Appeals.[28]

In his dissent below, Judge Smith cautioned that serious due process problems are engendered by such a *modus operandi*. He said:

> ". . . I am frankly unable to reconcile the procedural due process requirements of 35 U.S.C. 132 with the failure of the Patent Office here to comply with the notice requirements of this section. Certainly one need look no further than the majority

[28] See footnote 10, *supra*, pp. 12-13.

> opinion to see that the words 'unpatentable over' do not impart such information as to enable an applicant to 'judge of the propriety of continuing the prosecution of his application' as contemplated by section 132." (App., pp. 39a-40a)

Despite this caution, the same maneuver, for the very same purpose was again indulged by the majority below one month later in *Application of Folkers,* 344 F. 2d 967 (App., pp. 43a-48a). Judge Smith again dissented. He pointed out:

> "Moreover, just as I cautioned in Foster, we are here confronted with a prime example of denial of procedural due process to an applicant. The majority opinion fails to inform as to the precise ground of rejection in the present case, but proceeds as though the rejection were grounded on section 102(b). My study of the record has convinced me that no such rejection was ever made." (App. pp. 45a-46a)
>
> * * * *
>
> "Now appellant learns that what seems to have been a section 103 rejection is here sufficient to raise the issue of loss of right to patent under section 102(b). If I may be permitted an ad hominem, this is truly learning the hard way. For this is one case in which it is painfully clear that the appealed rejection did not provide the applicant 'with such information * * * as may be useful in judging of the propriety of continuing the prosecution of his application,' to which he is entitled under 35 U.S.C. 132. In addition, the present majority seems to have little regard for the jurisdictional limits of this court, in that it now decides an issue that was never presented below. I find nothing in sections 141 through 146 of Title 35 which could, even by the most imaginative lawyer, be interpreted to permit this court to decide

an appeal on the basis of section 102(b) when the only rejection was for obviousness under section 103". (App. pp. 47a-48a)

One week after the *Folkers* decision, in *Application of Hughes,* 345 F. 2d 184, decided May 20, 1965, the majority refused to consider a section *103* rejection urged by the Solicitor when the record made it "clear that the Examiner's action was based on section *102*" [345 F. 2d at 185]. In that majority opinion, written by Judge Smith, the court tacitly admitted its prior errors in *Folkers* and *Foster—viz.,* that it exceeded the limits of its jurisdiction under 35 U.S.C. 144 and condoned a Patent Office violation of procedural due process consequent from failure to give the mandatory notice required by section 132.

After noting that the examiner's action "was based on section 102," the majority in *Hughes* stated:

> "Our appellate jurisdiction is restricted by 35 U.S.C. § 144 to hearing and determining the appeal 'on the evidence produced before the Patent Office.' It seems basic to the concept of procedural due process that an applicant at least be informed of the broad statutory basis for rejecting his claims, so that he may determine what the issues are on which he can or should produce evidence. In order to insure that an applicant be so informed, 35 U.S.C. § 132 requires that whenever a rejection is made, the Commissioner 'shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application * * *.'
>
> * * * *
>
> "We cannot agree with the solicitor that there is no material difference between sections 102 and

103 with respect to an applicant's right to a day in court. *A rejection under section 102 involves a comparison between the subject matter disclosed by the reference and the claimed invention, in order to determine whether the claimed invention is 'described' in the reference. See, e.g., In re Sheppard, 339 F. 2d 238, 52 CCPA 859. Section 103, on the other hand, requires consideration of the differences between the claimed invention and the prior art, for the purpose of determining whether the claimed subject matter as a whole would have been 'obvious' to one of ordinary skill in the art. Thus, the issues arising under the two sections may be vastly different, and may call for the production and introduction of quite different types of evidence.*

"Accordingly, to the extent the board's decision goes beyond the examiner's rejection, which we have found to be for want of novelty under section 102, it will not be considered, since appellant never received adequate notice of any other ground of rejection which may or may not have been relied upon by the Board of Appeals." [345 F. 2d at 185, 186]

The underlined portion of the foregoing quotation is essentially a verbatim reproduction of the major portion of footnote 7 of Judge Smith's dissenting opinion below (App., p. 39a) which the majority had rejected a scant five weeks before *Hughes* was decided.

The "basic . . . concept of procedural due process . . ." by which the court was guided in *Hughes* in refusing to permit the Solicitor to shift the basis of rejection from section 102 to 103 applies, with equal

force, of course, to the shift of the majority below from "the rejection under section 103" urged by the Solicitor, to a new rejection fundamentally "predicated" on its "construction of section 102(b)." (App., p. 22a)

In *Hughes,* Chief Judge Worley and Judge Martin, who concurred in the majority opinion below, dissented from the due process holding of the majority. In their dissent they took the position that the court was entitled to consider the section 103 rejection advanced by the Board because the appellant elected to "waive" his right to due process under certain Patent Office rules which would have afforded an administrative remedy by proceeding directly on appeal. This position of the dissenting judges is a tacit recognition that, absent such an administrative remedy, due process is violated when the court below considers a new rejection not advanced by the Patent Office.

In this case, of course, no such administrative remedy was available from the *sua sponte* assertion by the court of a new rejection not advanced by the Patent Office.

Despite the conflict between *Hughes* and the majority opinion below, the *Hughes* case does not have the effect of overruling or otherwise modifying the decision in this case. Both this case and *Hughes* stand as the law and both the Patent Office and the court below are free to rely upon either in defense of their actions as they may see fit. The need for guidance from this Court on this point is self-evident. Review

should be granted here for the purpose of supplying such guidance.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

IN THE MATTER
OF THE
APPLICATION OF FREDERICK C. FOSTER,
Petitioner

APPENDIX TO PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

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APPENDIX TO PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CUSTOMS AND PATENT APPEALS

Constitutional and Statutory Provisions Involved

Article I, Section 8, clause 8, of the Constitution of the United States provides:

"The Congress shall have Power

* * * * *

"To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

35 U.S.C. 6 provides:

"§ 6. Duties of Commissioner

"The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trade-marks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

35 U.S.C. 102(a) and (b) provide:

"§ 102. Conditions for patentability; novelty and loss of right to patent

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . ."

35 U.S.C. 103 provides:

"§ 103. Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would

have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

35 U.S.C. 132 provides:

"§ 132. Notice of rejection; reexamination

"Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention."

35 U.S.C. 144 provides:

"§ 144. Decision on appeal

"The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case."

35 U.S.C. 282 provides:

"§ 282. Presumption of validity; defenses

* * * * *

"The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

* * * * *

"(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability, . . ."

R.S. 4886, as amended, provided:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

In the Matter of the Application of Foster

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

No. 7106 Decided Apr. 15, 1965

Appeal from the United States Patent Office

ALMOND, Judge.

This is an appeal from the decision of the Board of Appeals affirming the rejection of the claims in appellant's patent application.[1]

The invention relates to elastomeric synthetic polymers said to combine the desirable properties of natural Hevea rubber and the presently employed synthetic rubbers. These properties are described in the specification:

> "Hevea natural rubber is characterized by excellent tack, especially after milling; thus being ideal for tire building operations. Hevea produces vulcanizates having excellent resilience and low hysteresis properties, high tensile strength, and good flexibility at low temperatures. Gum vulcanizates formed from Hevea also possess high tensile strength. Hevea natural rubber is characterized by a crystallinity of at least about 40% and displays a crystalline X-ray diffraction pattern when stretched."

> "Heretofore, the synthetic rubbers, in comparison with Hevea rubber, have exhibited low tack and no crys-

[1] Serial No. 605,440, filed August 21, 1956, for "Butadiene Polymers and Copolymers Thereof."

talline properties while their vulcanizates have been characterized by undesirably low tensile strengths and resilience, and undesirably high hysteresis. The synthetic rubbers, particularly the butadiene/styrene copolymer (GR-S), have been greatly superior to natural rubber in resisting crack initiation in service but have been markedly inferior to Hevea in resisting crack and cut growth. The undesirably high hysteresis of the synthetic rubbery polymers has prevented their use in any substantial quantity in the production of such articles as the large tires employed on trucks, buses, and large off-the-road vehicles.''

Infrared analysis of Hevea rubber has shown that the polymer consists of about 97.8% cis-1, 4-structure. That is, the units of the rubber molecules are connected to each other in 1, 4-addition to produce a linear chain with the spatial arrangement of the units in what is called the cis, as opposed to the trans, stereospecific configuration.[2]

---

[2] The various polymer configurations which may result from the polymerization of conjugated diene are explained in Whitby, Synthetic Rubber, at 289, 290 (1954):

''In a butadiene polymer the two units that may occur in the chain are the 1, 4-unit (I) and the 1, 2-unit (II). When a monosubstituted butadiene such as isoprene is polymerized the possibilities are greater, for the 1, 4-units may be united 'head-to-head and tail-to-tail' (III) and head-to-tail (IV), and, further, addition may occur 1, 2 at the substituted double bond to produce the 1, 2-unit (V) or 3, 4 at the unsubstituted double bond to produce the 3, 4 unit (VI).''

''It should be noted that structures I, III, and IV are capable of existing in cis and trans configurations at each double union, and that structure [sic] II, V, and VI have asymmetric carbon atoms which make optical isomerism possible.''

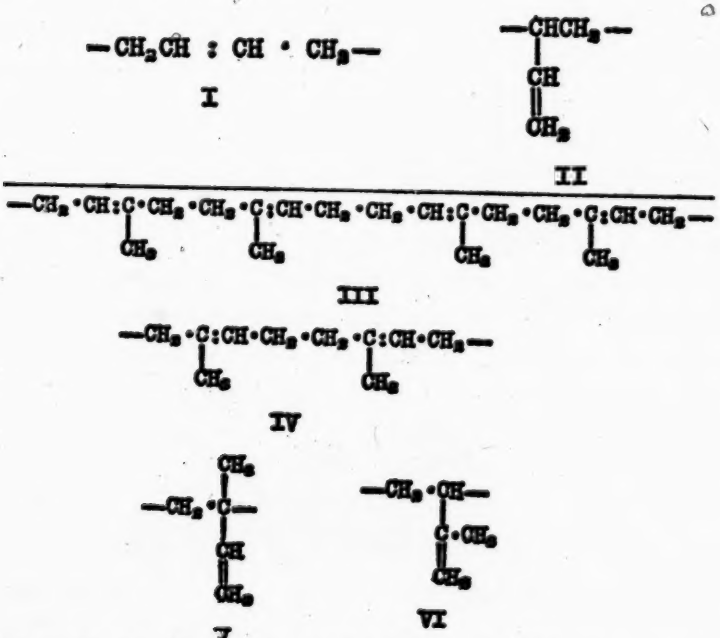
Footnote 2 continued on page 7a.

In contrast, the specification notes that "The butadiene portion of a typical GRS emulsion copolymer contains about 64% trans-1,4-structure, 18% cis-1,4-structure and 18% 1,2-structure."

By increasing the amount of cis-1,4-structure butadiene, the properties of the synthetic rubber are greatly improved.

All of the claims are drawn to synthetic polymer products, although some contain limitations as to how the polymer is formed (e.g., "by solution polymerization"). A wide variety of combinations is claimed, but broadly three groups emerge. Some of the claims[3] specify a certain amount of cis-1,4-structure polymer, as, for example, claim 12, which reads:

> "A synthetic polymer selected from the group consisting of rubbery homopolymers of butadiene-1,3 and rubbery copolymers of butadiene-1,3 and styrene; said



I II III IV V VI

[3] Claims 12, 13, 17, 18, 29, 30, 32, 33, 34, 35, 36, 39 and 40.

synthetic polymer being characterized by a cis 1,4-structure of at least 23% and a 1,2-structure not in excess of 15% of the polymeric butadiene present in the polymer."

Other claims[4] merely specify that the head-to-tail structure be present (a type of 1,4-structure without denomination as cis- or trans-). Representative of these is claim 25:

"A synthetic polymer selected from the group consisting of rubbery homopolymers of butadiene-1,3 and rubbery copolymers of butadiene-1,3 and styrene; said synthetic polymer being characterized in that at least 85 per cent of the butadiene monomer units thereof are joined in a head-to-tail relationship."

Finally, there is claim 28:

"Products comprising conjugated polyolefin hydrocarbon polymers and copolymers in which the conjugated polyolefin monomer units are present in 1,4 additional polymer structure."

Although the specification, the original claims, the decision of the board, the briefs on appeal, and the oral arguments stress the importance of the high percentage of cis-1,4-stereoconfiguration as contrasted with trans-1,4, and the low percentage of 1,2-structure in producing the results obtained (counsel for appellant characterized the invention as a "breakthrough"), we note that the second and third groups of claims outlined above are not limited to the cis-stereoconfiguration. Nevertheless, no issue was raised on whether the invention is properly defined without specifying the cis-configuration, our attention being directed to other issues raised in the 415 pages of printed record.

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[4] Claims 22, 23, 25 and 26.

The examiner and the Board of Appeals rejected all of the claims on the basis of the Binder reference. The record indicates that Binder, an employee of appellant's assignee, wrote an article in the magazine "Industrial and Engineering Chemistry."[5] The article reports analyses of the miscrostructures of polybutadiene homopolymers and copolymers with styrene. The portions particularly relied upon by the Patent Office are:

1. Table V which lists polymer "39-1" as having 22.7% cis-1,4; 60.0% trans-1,4; and 17.3% 1,2 structures of butadiene. It is noted that the catalyst employed was a peroxide.

2. Conclusion: "The results of the analyses reported here show that while the amount of cis-1,4 addition increases with increasing temperature of polymerization, a polybutadiene containing 100% cis-1,4 or trans-1,4 addition cannot be made at any practical temperature."

It also should be noted that the Binder report at the outset states: "During the past 2 years, a large number of polybutadienes and butadiene-styrene copolymers have been prepared in these laboratories, in which various changes were made in the recipes with the object, mainly, of increasing the amount of cis-1,4 addition."

One of the issues presented is: What is the statutory basis of the rejection on prior art? Appellant contends it is 35 U.S.C. 103 and the solicitor contends it is both section 103 and section 102. Neither the examiner nor the board mentioned any statute section.

The examiner rejected the claims "as unpatentable over Binder" in the final rejection, the first office action printed in the record on appeal. Appellant submitted a number of papers which the examiner found failed "to place the case in condition for allowance." The examiner repeated the "unpatentable over Binder" rejection, but added in the

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[5] Vol. 46, No. 8, pp. 1727-1730, August 1954.

same paragraph "The claimed polymer only differs in degree and not in kind from the prepared polymer of Binder and is *anticipated* by the disclosure of 100% cis 1,4 polybutadiene on page 1730 of the article." [Emphasis supplied.] Appellant responded that the word "anticipated" raised a new issue and a new rejection and sought to amend the application. The examiner refused to enter the amendment, but repeated the statement that "a polymer containing the claimed structure is anticipated by Binder." Appellant then petitioned to the Commissioner of Patents whose decision stated:

> "Under all the circumstances and in view of the facts now brought out in the petition, it is concluded that it would be advisable to enter the appellant's proposed claims 39 and 40 and to permit the examiner in his answer to the appeal to rely on the Binder patent [sic] either as an anticipation or as a basis for a rejection on lack of invention, or both, as he may see fit."

The examiner then wrote his answer which was divided into several headings. Under "The Reference," the examiner concluded with the statement:

> "Note that Binder does *not* say that 100 [sic] cis 1,4 polybutadiene *cannot* be made. Binder merely states that cis-1,4 polybutadiene cannot be made in the *particular emulsion systems* discussed at any practical temperature. Hence, the naming of 100% cis-1,4 polybutadiene by Binder is deemed to be a full disclosure of said polymer. In re Von Bramer et al., 542 O.G. 183, 53 USPQ 345."

Immediately below this, under "The Rejection," the examiner stated that the "claims 22, 23, 25, 26 and 28 which read upon a butadiene polymer characterized by possessing a 100% cis 1,4 or 100% trans 1,4 structure are deemed unpatentable over" Binder, with no mention of "anticipation."

It is appellant's contention that the words "unpatentable over" mean that the statutory basis is section 103 and the word "anticipated" indicates reliance on section 102(b). Since there was no *rejection* on the ground of "anticipation," appellant argues that the statutory basis must be section 103.

We agree that the language employed is confusing and that it is not clear what section of the statute is intended. On the other hand, we are not convinced that there is any "magic" to the particular words used or that they can only mean reliance on section 103. The words "unpatentable over" do not *necessarily* mean reliance on section 103 *alone*. The statements of the rejections are sufficient for us to consider the rejections on both sections 102(b) and 103.

Considering first the rejection on the ground that Binder contains a full disclosure, we note that the examiner and the board relied on In re Von Bramer, 29 CCPA 1018, 127 F.2d 149, 53 USPQ 345, to support the proposition that the statement in Binder that "100% cis-1,4 * * * cannot be made" precludes issuance of a patent on the appealed claims.

We find persuasive the reasoning set forth in Phillips Petroleum Company v. Ladd, 219 F.Supp. 366, 138 USPQ 421 (D. D.C. 1963), the facts of which are strikingly similar to the present facts relevant to the issue of "anticipation." In that case the claims were drawn to include a rubbery 100% cis-1,4-polybutadiene. The solicitor there, as here, argued that the claims were anticipated by the conclusion in the same Binder article that the rubber could not be made. The court[6] said, 138 USPQ at 423-424:

> "With respect to the so-called disclosure in the Binder patent [sic], the position of counsel for defend-

[6] Jackson, J., retired Associate Judge of the Court of Customs and Patent Appeals, who, incidentally, was the author of the Von Bramer opinion.

ant is that since 100% cis is mentioned, it is such a disclosure as would deny patentability to the claims herein. Based upon the evidence, and a thorough analysis of Binder, it seems clear to the Court that defendant's contention amounts to nothing more than a vague negative hypothesis."

"With respect to products, distinguishing them from mere names, the involved polymers are defined by critical limitations, were not predictable, differed in kind from the prior art products, had not been made, and probably could not have been attained, until the present inventors made their discovery."

"Counsel for the defendant relied principally upon the case of In re Von Bramer, 127 F.2d 149, 29 CCPA 1018, 53 USPQ 345. In the opinion of the Court the Von Bramer case differs in its facts from the instant case. In that case, as maintained by counsel for plaintiff, the prior art disclosure was what is known as the 'Geneva' name of a chemical compound defining molecular structure. The properties claimed in the Von Bramer case differed only in degree from those admittedly disclosed in the prior art. As far as the predictable properties of the Von Bramer case is concerned, they were found in any similar compound, and those compounds were capable of synthesis by recognized classical organic reactions."

"Furthermore, in that case there were statements in a number of prior art references that the compound relied upon as anticipatory had been made and used, and that the five carbon atom alkyl limitation in that case contradicted the statement of the invention in the specification as an arbitrary and meaningless distinction from the prior art."

"* * * Polymers in the instant case differ in kind from the properties of polybutadienes of the prior art, and likewise, have properties which are unpredictable

in light of the prior art. Those polymers had not been made by any method of synthesis by skilled workers in the art, including Dr. Binder who made that admission in the reference, although many highly skilled scientists in the art had been working on these projects."

"Dr. Binder stated that he knew of no way to make 100% cis 1, 4 polybutadiene at any practical temperature, and there is a lack of any prior art statement that any such cis polybutadiene had ever been made, * * *."

Regarding the rejection predicated on full disclosure by Binder and reliance on the Von Bramer decision, we cannot sustain that rejection for the reasons given in the Phillips case with respect to the same prior art disclosure.

Considering the rejection on the ground of "unpatentability over" Binder, appellant points out that the board withdrew a rejection based on a patent to Greene after appellant submitted an affidavit under Rule 131. Appellant argues that the affidavit establishes a date of invention prior to the publication date of the Binder reference, and that this court's decision in In re Palmquist, 51 CCPA 839, 319 F.2d 547, 138 USPQ 234, compels a finding that Binder cannot be considered in establishing obviousness of the claimed invention under 35 U.S.C. 103.[7]

The solicitor points out that the Palmquist decision did not overrule In re Wenzel, 24 CCPA 1050, 88 F.2d 501, 33 USPQ 30, and states that Bros Inc. v. Browning Mfg. Co.,

[7] In view of the fundamental nature and relative simplicity of the invention here in issue, we assume that the Greene patent, which is not in the record before this court, discloses approximately the same information as the Binder article. No issue has been raised as to the showing that the proofs accepted for withdrawal of the Greene patent are sufficient to establish a date of invention prior to the effective date of the Binder reference.

317 F.2d 413, 137 USPQ 624, "appears to be contra to the Palmquist case." The solicitor also argues that the polymers listed on Binder Table V and the claimed polymer "are only so slightly *different* from the latter structure as to be of no legal significance," [emphasis present] and that

> "* * * the slight differences in the amount of cis-1, 4 and 1, 2 structure between the polymer of the claims and that of Binder does not come within the purview of the requirement for unobviousness of Section 103 to justify allowance of a patent. Even under the Palmquist case it is doubted that this difference would be acceptable."

It is assumed by both parties—and it is unquestionably true—that when a reference fully discloses in every detail the subject matter of a claim, the statutory basis of a rejection on that reference is 35 U.S.C. 102(a) if the reference date is before the applicant's *date of invention,* thereby establishing want of novelty, and section 102(b) if the reference date is more than one year prior to the actual United States *filing date,* thereby establishing a so-called "statutory bar," more accurately, a one-year time-bar which results in loss of right to a patent, regardless of when the invention was made. In either of these situations, it is often said that the invention is "anticipated" by the reference and the reference is termed an "anticipation."

Proofs submitted in this case under Patent Office Rule 131 with respect to a reference not before us (because it was overcome thereby) have established that the applicant's invention date was prior to December 26, 1952. The Binder reference is the August 1954 issue of a periodical. It is seen, therefore, that it is subsequent to the date of invention but more than one year prior to the filing date, which was August 21, 1956. This is the same relationship of dates which existed in Palmquist as regards the Van

Boskirk reference. Since the date of invention is earlier than the reference date, section 102(a) is necessarily inapplicable because the printed publication was not "before the invention thereof by the applicant" and there is statutory novelty. This leaves paragraph (b) of section 102 as the only paragraph of that section having possible relevancy.

It is appellant's position, as stated in his Reply Brief, that

> "The *only* issue on this appeal is whether the claims define subject matter which is obvious in view of the reference and hence unpatentable under 35 U.S.C. § 103. * * *"

Deeming that to be the sole issue, appellant further contends that the assumed rejection under section 103 is not before the court because, under Palmquist, the Binder reference has been disposed of by the proof of an invention date prior to the date of Binder and this reference is not before us. Disposing of the sole reference in this manner of course disposes of the "unpatentable over" rejection.

There is a difference in the facts in this case from the facts in Palmquist in that there is only one reference here, there being differences between the claimed subject matter and the reference disclosure which the Patent Office contends would be obvious to one of ordinary skill in the art, whereas in Palmquist the claims were rejected on various combinations of two or three references, each combination involving one reference which had a date subsequent to the date of invention but more than one year prior to applicant's filing date. The Patent Office seeks to distinguish Palmquist on the basis of the differences in the factual situations. As will appear from what follows, we consider this difference to be of no legal significance.

Because of the importance of the question to the law of patents, we have deemed it desirable to reconsider what

is the statutory basis of this "unpatentable over" or obviousness type of rejection, such as we have here and had before us in Palmquist, under the circumstance that *the reference or references have effective dates more than one year prior to the filing date of the applicant.* More specifically, we have reconsidered the result again urged on us here, as allegedly authorized by section 103, that a reference having a date more than a year prior to the filing date may be disposed of by showing an invention date prior to the reference date, contrary to the express provision in Patent Office Rule 131.[8]

Sections 101, 102 and 103, generally speaking, deal with two different matters: (1) the factors to be considered in determining whether a patentable invention has been *made,* i.e., novelty, utility, unobviousness, and the categories of patentable subject matter; and (2) "loss of right to patent" as stated in the heading of section 102, even though an otherwise patentable invention has been made. On the subject of loss of right, appellant's brief contains a helpful

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[8] *131. Affidavit of prior invention to overcome cited patent or publication.* (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, *unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.* [Emphasis ours.]

The italicized clause at the end of the foregoing paragraph or its equivalent has been present in the rule and its predecessor Rule 75 sinc January 1, 1898, when the rule was amended to include:

> "* * * unless the date of such patent or printed publication is more than two years prior to the date on which application was filed in this country."

review of the development of the statutory law since 1793. It says:

> "In 1897 the patent laws were amended to make the * * * two-year bar period apply to all public uses, publications and patents *regardless of the source* from which they emanated. The change was a consequence, primarily, of greatly improved communications within the country which had rendered inventors easily able to acquire knowledge of the public acts of others within their own fields. It was reasoned that any inventor who *delayed in filing* a patent application for more than two years after a public disclosure of the invention would obtain *an undeserved reward in derogation of the rights of the public* if he were granted a patent."
>
> "In 1939, in recognition of further improvements in communications, Congress reduced the two-year bar period to one year. * * *"
>
> "That 1939 Act was carried over unchanged in the 1952 recodification of the patent laws as 35 U.S.C. § 102(b). * * *"
>
> "Manifestly, Section 102(b) from its earliest beginnings has been and was intended to be directed toward the encouragement of *diligence* in the filing of patent applications and the protection of the public from monopolies on subject matter which had already been fully disclosed to it."

These statements are in accord with our understanding of the history and purposes of section 102(b). It presents a sort of statute of limitations, formerly two years, now one year, within which an inventor, even though he has made a patentable invention, must act on penalty of loss of his right to patent. What starts the period running is clearly the availability of the invention *to the public* through the categories of disclosure enumerated in 102(b), which include "a printed publication" anywhere describing

the invention. There appears to be no dispute about the operation of this statute in "complete anticipation" situations but the *contention seems to be that 102(b) has no applicability where the invention is not completely disclosed in a single patent or publication,* that is to say where the rejection involves the addition to the disclosure of the reference of the ordinary skill of the art or the disclosure of another reference which indicates what those of ordinary skill in the art are presumed to know *and to have known for more than a year before the application was filed.* Upon a complete reexamination of this matter, we are convinced that the contention is contrary to the policy consideration which motivated the enactment by Congress of a statutory bar. On logic and principle we think this contention is unsound, and we also believe it is contrary to the patent law as it has actually existed since at least 1898.

First, as to principle, since the purpose of the statute has always been to require filing of the application within the prescribed period after the time the public came into possession of the invention, we cannot see that it makes any difference *how* it came into such possession, whether by a public use, a sale, a single patent or publication, or by combinations of one or more of the foregoing. In considering this principle *we assume, of course,* that by these means *the invention has become obvious* to that segment or [sic] the "public having ordinary skill in the art." Once this has happened, the purpose of the law is to give the inventor only a year within which to file and this would seem to be liberal treatment. Whenever an applicant undertakes, under Rule 131, to swear back of a reference having an effective date more than a year before his filing date, he is automatically conceding that he made his invention more than a year before he filed. If the reference contains enough disclosure to make his invention obvious, the principle of the statute would seem to require denial of a patent to him. The same is true where a combination of

two publications or patents makes the invention obvious and they both have dates more than a year before the filing date.

As to dealing with the express language of 102(b), for example, "described in a printed publication," technically, we see no reason to so read the words of the statute as to preclude the use of more than one reference; nor do we find in the context anything to show that "a printed publication" cannot include two or more printed publications.[9] We do not have two publications here, but we did in Palmquist, and it is a common situation.

As to what the law has been, more particularly what it was prior to 1953, when the new patent act and its section 103 became effective, there is a paucity of direct precedents on the precise problem.[10] We think there is a reason for this. Under the old law (R. S. 4886, where 102(b) finds its origin) patents were refused or invalidated on references dated more than a year before the filing date because the invention was anticipated or, if they were not then *because there was no "invention,"* the latter rejection being based either on (a) a single nonanticipatory reference plus the skill of the art *or (b) on a plurality of references.* There was no need to seek out the precise statutory basis because it was R.S. 4886 in any event, read in the light of the Supreme Court's interpretation of the law that there must always be "invention." This issue was determined on the disclosures of the references relied on and if they had

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[9] The construction of section 102(b) is subject to the provision of 1 U.S.C. 1 which provides in pertinent part:

> "In determining the meaning of any Act or resolution of Congress, words, importing the singular number may extend and be applied to several persons or things; * * * unless the context shows that such words were intended to be used in a more limited sense; * * *"

[10] For an attempt to relate prior decisions to the problem, see 32 Geo. Wash. L. Rev. 656.

dates more than one year before the filing date, it was assumed they could be relied on to establish a "statutory bar." There was an express prohibition in Rule 131 and in its predecessor Rule 75 against antedating a reference having a date more than a year prior to the filing date and there was no basis on which to contest it. The accepted state of law is exemplified by the following sentences in McCrady's Patent Office Practice, 4th ed. (1959), Sec. 127, p. 176:

> "Prior art specified by 35 U.S.C. 102, which has an effective date more than one year prior to the effective filing date of an application, constitutes a bar under the language of that statute. Until 1940 the period was two years."
>
> * * *
>
> "Procedurally, the significance of the statutory bar lies in the fact that it cannot be antedated by evidence of applicant's earlier invention, as by affidavits under Rule 131, or by evidence presented in an infringement suit."

Our decision in Palmquist appears to have been the first to hold otherwise.

The various editions of Walker on Patents from an early time have included this statement, quoted from the 2nd Deller Edition § 141 (§ 87 in 1st Dell. ed.):

> "Precise identity between the thing covered by the patent and the thing which the inventor allowed to be in public use or on sale more than the statutory period before he applied for the patent is not necessary to constitute constructive abandonment of the invention covered by the later. It is enough * * * if the advance from one to the other did not amount to invention [Int'l Tooth Crown Co. v. Gaylord, 140 U.S. 55 (1891)]."

Thus the "statutory bar" has not been limited to "complete anticipation" fact situations where the complete disclosure of the invention is to be found in a single reference. At least the skill of the art has been added to the disclosure of the reference or the thing in public use in finding a bar to the grant of a valid patent, utilizing the standard pre-1953 terminology of "no invention."

It would seem that the practical operation of the prior law was that references having effective dates more than a year before applicant's filing date were always considered to be effective as references, regardless of the applicant's date of invention, and that rejections were then predicated thereon for "lack of invention" without making the distinction which we now seem to see as implicit in sections 102 and 103, "anticipation" or no novelty situations under 102 and "obviousness" situations under 103. But on further reflection, we now feel bound to point out that of equal importance is the question of *loss of right* predicated on a one-year *time-bar* which, it seems clear to us, has never been limited to "anticipation" situations, involving only a single reference, but has included as well "no invention" (now "obviousness") situations. It follows that where the time-bar is involved, *the actual date of invention becomes irrelevant* and that it is not in accordance with either the letter or the principle of the law, or its past interpretation over a very long period, to permit an applicant to dispose of a reference having a date more than one year prior to his filing date by proving his actual date of invention.

Such a result was permitted by our decision in Palmquist and to the extent that it permitted a reference, having a publication date more than one year prior to the United States filing date to which the applicant was entitled, to be disposed of by proof of a date of invention earlier than the date of the reference, that decision is hereby overruled.

We wish to make it clear that this ruling is predicated on our construction of section 102(b) and has no effect on the statements in Palmquist respecting the determination of obviousness under section 103 when a statutory time-bar is not involved. The existence of unobviousness under that section, as a necessary prerequisite to patentability, we reiterate, must be determined as of "the time the invention was made" without utilizing after-acquired knowledge.

The determination of unobviousness, however, relates to the determination of whether a patentable invention has been *made*. Whether there has been a *loss of right to a patent* on such invention is a distinct and separate issue, with which section 103 per se has nothing whatever to do. Its legislative history, which is well known and uncomplicated, shows that section 103 had but a single purpose which was to add to the statute a provision to take the place of the judge-made "requirement for invention." In doing that, the history also shows, the words "at the time the invention was made" were included for the sole purpose of precluding the use of hindsight in deciding whether an invention is obvious. We are sure Congress had no intent thereby to modify the law respecting *loss of right* based on the existence of a time-bar. We have therefore concluded that we were wrong in accepting the appellants' contentions in Palmquist that those words enabled Palmquist and Erwin to dispose of a reference relied on to establish a one-year bar by showing a date of invention earlier than the date of the reference. The wrong in such a construction of the statute—beside giving it a meaning that was never intended—is that it permits an inventor to sleep on his rights more than a year after the invention has become entirely obvious to the public, whereby the public has potential possession of it, and still obtain a patent which will take the invention from the public, a result Congress could not possibly have intended in view of its express indication that section 102(b) is merely a continuation of the prior law.

Since we must reject Foster's contention that he can dispose entirely of Binder by showing an earlier invention date, it becomes necessary for us to consider whether there was a loss of right to a patent, i.e., whether the invention became obvious to the public at the time of the Binder publication. Appellant has fully argued this issue in his briefs.

The solicitor contends that all claims were rejected over the Binder disclosure of polymer "39-1" which contains 22.7% cis-1,4 and 60.0% trans-1,4 structures. We cannot agree. Our analysis of the record indicates that polymer "39-1" was never employed in the rejection of claims 22, 23, 25, 26 and 28. Those claims specify a minimum 1, 4 content and were rejected only as being anticipated by the 100% cis-1,4-disclosure of Binder. Although the solicitor argues that claims such as 25 which calls for a polymer having 85% head-to-tail structure are obvious in view of the "39-1" polymer which has 82.7% 1, 4-structure, we do not feel that we can properly consider that argument since appellant was not afforded a proper opportunity to meet these arguments which were made neither by the examiner nor by the board.

The "39-1" polymer, as well as others from Table V of Binder, did clearly form the basis of rejecting the remaining claims. Since the cis-1, 4 content formed the basis of the examiner's comparison of the appellant's polymers with those of Binder, we shall group the claims for discussion on the basis of the cis-1, 4 content specified. Claim 34 calls for "at least about twenty-nine per cent of said monomer units being present in cis-1, 4 structure." Claim 35 calls for "from about thirty to about fifty-seven per cent of said butadiene monomer units being present in cis-1, 4 structure."

After a rejection based upon the "39-1" polymer and a polymer containing 22.4% cis-1,4, 60.5% trans-1,4 and 17.1% 1, 2 which was designated by Binder as polymer

"1140," appellant submitted an affidavit comparing his "Diene rubber," a polybutadiene containing 29.1% cis-1,4; 61.3% trans-1,4; and 9.6% 1,2 with ten polymers disclosed by Binder. This affidavit by Dr. Bernard L. Johnson, an employee of Firestone, indicated that precise duplication of the Binder polymerization methods was possible because all of the Binder work had been done at Firestone and Binder's original data was still available. Furthermore, Binder determined the miscrostructures and properties of the reproduced polymers. Despite this assistance, however, Johnson was unable to reproduce several polymers including the "1140" polymer. Instead, he obtained a fluid containing 19.2% cis-1,4; 61.1% trans-1,4 and 19.1% 1, 2-structures. All of the other reproduced polymers were rubbery solids. The board stated that the "1140" polymer was the closest prior art and thus could not accept appellant's showing as being a comparison with the closest Binder polymer.

The solicitor has pointed out what he considers to be another defect in the affidavit. The "Diene rubber," a butadiene homopolymer, was compared with various butadiene homopolymers and butadiene-styrene copolymers, but was not compared with "FR 89-2," the closest butadiene homopolymer disclosed by Binder. We note that although "Diene rubber" was not compared with "FR 89-2" which contained 21.9% cis-1,4, it was compared with "FR 89-1" which contained 20.5% cis-1,4. The criticisms raised by the board and the solicitor may bear on the weight to be given the affidavit, but they do not preclude our consideration of the affidavit.

Several of the Binder polymers are as good as or better than "Diene rubber" with regard to strength as measured by dynamic modulus and static modulus. However, the "Diene rubber" is clearly superior with regard to several other properties. Heat build up, as evidenced by relative energy absorption at constant force, is from about 53% to over 540% higher in the Binder polymers. The rebound

value of the "Diene rubber" is from 40% to over 100% greater at room temperature and when cured in a tread stock from about 40% to 170% greater at room temperature and from 18% to about 200% greater at 212° F. than the rebound values of the Binder polymers. The "Diene rubber" resistance to low temperatures, as evidenced by Young's Bending Modulus, is from 20% to 170% greater than that of the Binder polymers. It should be noted that in all of these tests the Binder "FR 89-1" butadiene homopolymer containing 20.5% cis-1,4 performed the best or close to the best of all of the Binder polymers tested. We are convinced, however, that appellant's "Diene rubber" containing 29.1% cis-1,4-polybutadiene has properties superior to and is patentable over the Binder polymers, all of which contain less than 23% cis-1,4-structure.

We have considered the solicitor's argument that because natural rubber contains 97.8% cis-1,4-structure, it would be obvious to increase the cis-1, 4 content of the Binder polymers to obtain the properties achieved by appellant in his "Diene rubber." We cannot agree with this position. Natural rubber contains isoprene units, not butadiene units. Thus, appellant has discovered that his "Diene rubber" (polybutadiene) has properties similar to or better than natural rubber (polyisoprene). We, accordingly, *reverse* the rejection of claims 34 and 35.

Another group of claims, 12, 13, 29 and 39, specifies a cis-1, 4 content of as low as 23%, only a fraction of a per cent more than the Binder polymers have. The board held that the affidavit failed to show a difference between the Binder polymers and the claimed 23% cis-1, 4 polymers. Appellant has not introduced evidence to show that the 23% cis-1,4 containing polymer has properties differing in any way from the Binder polymers. Neither has he shown that the 23% cis-1,4 containing polymers are more closely related to his 29.1% cis-1,4 containing "Diene rubber" than to the Binder polymers. He also failed to present arguments that the small percentage differences in the total 1,4

content are significant. Thus, we agree with the board that the mere difference of a fraction of a percent does not render the claims unobvious in view of Binder.

Claims 17 and 18 are drawn to sulfur-cured vulcanizates of the 23% cis-1,4 containing polymers. Appellant has not argued that sulfur curing would be an unobvious treatment of the products. We thus agree with the solicitor that these claims must fall with the polymer claims.

Product claims 30, 32, 33, 36 and 40 contain limitations specifying the method of forming the 23% cis-1,4 containing polymer, e.g., "said synthetic polymer being formed in the presence of an ionic catalyst in a substantially nonaqueous system * * *." While it is appellant's position that high cis-1, 4 contents cannot be achieved by Binder's polymerization process, he has not argued in his brief that there is an unobvious difference between the claims based upon the method limitation. Because appellant has not shown that polymers containing 23% cis-1, 4-structure produced according to his claims must differ significantly from the Binder polymers, we agree with the board.

We, accordingly, *reverse* the decision of the Board of Appeals with regard to claims 22, 23, 25, 26, 28, 34 and 35. The rejection of claims 12, 13, 17, 18, 29, 30, 33, 36, 39 and 40 having been *affirmed* because the appellant has lost his right to these claims, the decision is *modified.*

WORLEY, Chief Judge, concurring.

Had not circumstances prevented my participation in Palmquist, I doubtless would have joined my colleagues in adopting appellants' then plausible interpretation of Section 103. There can be no doubt that the language therein, when interpreted *literally* and standing *alone,* supports Palmquist. But, as the majority makes so clear here, we misinterpreted Congressional intent there. No court is infallible, and the margin for error becomes greater in the complexities of patent law, increasing with the heavy case

load[1] the court is attempting to carry. It is comforting to note that on those happily rare occasions when mistakes are made the court has not hesitated to set the record straight and prevent bad law from becoming precedent for more bad law.

That Palmquist was new law[2] is evident from In re Wenzel, 24 CCPA 1050, 88 F.2d 501, 33 USPQ 30; In re Ruscetta, 45 CCPA 968, 255 F.2d 687, 118 USPQ 101; Ex parte Austin, 72 USPQ 384. That the result there was also foreign to Congressional intent and policy is equally clear. For example, the statute is designed to *encourage* early filings so the public may the sooner benefit, yet Palmquist discouraged that goal. Indeed, it placed a premium on late filing, and created a virtual open season on the public by permitting "obvious" subject matter already in the public domain for more than one year to be patented.[3] I am confi-

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[1] In 1958 patent appeals to this court totaled 83; six years later the number had reached 245, a 200% increase.

[2] In this connection, it is not without interest to note that Foster did not argue at any time before the board that his Rule 131 affidavit removed the Binder publication as a reference. The board's decision on reconsideration is dated Sept. 17, 1962. This court rendered its decision in Palmquist on June 28, 1963.

[3] In further consideration of the record before us here, it seems to me that the subject matter of claims 25, 26 and 28, as broadly stated, is unpatentable under 35 U.S.C. 102(b) alone, because the subject matter was described in toto in the Binder printed publication more than one year prior to appellant's filing date. In concentrating upon the rejection of those claims over the "conclusion" portion of Binder, the Patent Office appears to have overlooked several polymers of butadiene and copolymers of butadiene-styrene disclosed by Binder which have "at least 85%" of the butadiene units joined in head-to-tail or 1, 4 addition polymer structure as called for in the claims. Those polymers, appearing in Tables 1 and 2 of Binder, are identified, for example as Polymer Nos. 995, 1075, 1060 and 1113. However, the jurisdiction of this court being limited under 35 U.S.C. 141-144, we cannot enter a new ground of rejection. In re Thompson, 52 CCPA 770, 336 F.2d 604, 143 USPQ 21. I comment no further on the patentability of those claims without the benefit of the views of the Patent Office and appellant.

dent neither the court nor Congress intended such a result. Nor could either have intended to shroud the validity of issued patents in perennial doubt, or encourage the danger of legal harassment for which Palmquist might well have become a potent source. It is well that we close the door here on those possibilities.

RICH, Judge, concurring.

In view of the opening remarks of Judge Smith's dissent and because of the unusually long time the decision in this case has been gestating, I merely wish to record the fact that last August I first developed the tentative view that we committed an error of law in Palmquist and became firmly convinced of it and of its exact nature in early October after reviewing the Palmquist record. I regret that until then I had not fully appreciated the explicit and detailed reliance by the examiner in that case on the existence of a one-year bar and on 35 U.S.C. 102(b) as the basis of his rejection.

SMITH, Judge, dissenting.

Less than two years ago I spoke for a unanimous court in the Palmquist case. Today I find myself the lone dissenter from a decision which overrules it. What has happened in the interim to convince three of the original participants in that short-lived decision that it should be overruled?

The answer emerges from the opinions of the majority and from various commentaries on the Palmquist case.[1] Very simply this answer is that neither sections 102 and 103 of the Patent Act of 1952 cover the situation presented here or in Palmquist. To plug the "hole" which has been shown to exist in the Patent Act of 1952, the majority rests

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[1] See Sobel, Prior Art and Obviousness, 47 J. Pat. Off. Soc'y 79 (1965), a substantial portion of which is given over to a discussion of Palmquist and related cases. Palmquist is noted in 13 Am. U.L. Rev. 211 (1964) and 32 Geo. Wash. L. Rev. 656 (1964).

its opinion upon the unsupportable premise that sound patent policy dictates that an inventor shall lose his right to a patent in every case in which his invention becomes obvious at any time prior to one year before he files his patent application.

I am convinced and shall point out in this opinion: 1) that no such broad patent policy exists and 2) even if it did, that this court is not justified in reaching so far to correct a legislative oversight. I shall also point out some of the very undesirable consequences I see flowing from today's decision.

I. *Is there a pervasive patent policy which dictates today's decision?* The answer, of course, is no. There are at least two, and perhaps more situations wherein an invention, unobvious when made, later becomes obvious sometime prior to one year before the application is filed and yet the applicant does *not* lose his right to patent. The following examples will make this clear.

First: At page 171 of the instant majority opinion we find the statement: "Proofs submitted in this case under Patent Office Rule 131 with respect to a reference not before us (because it was overcome thereby) have established that the applicant's invention date was prior to December 26, 1952." What the majority opinion does *not* state is that December 26, 1952 is the *filing* date of this "reference not before us," which is the Greene U.S. Patent 2,762,790 issued a few weeks subsequent to the date on which appellant filed his application. Thus, Greene's application was co-pending with appellant's, and Greene's filing date was something over *three* years prior to appellant's.[2]

[2] The underlying condition specified in rule 131(a) is that the invention be substantially shown or described, but not claimed, in the domestic patent used as the reference. In accepting the affidavits under this rule and removing the Greene patent as a reference, we must assume that the Patent Office considered that this underlying condition of rule 131 had been met and that Greene did describe Foster's invention.

In In re Harry, 51 CCPA 1541, 333 F.2d 920, 142 USPQ 164, we held that 35 U.S.C. 102(e) operates not only in situations where the invention is described in a single patent, but also in situations where the invention is obvious in view of a combination of patent [sic]. Thus in considering the Greene patent as a reference, appellant's invention would, under the Harry case, have become obvious as of the filing date of the Greene application. Since that date is considerably more than one year prior to appellant's filing date, it follows logically from the majority view here that appellant should have been denied his patent because as a matter of law Greene made the invention obvious more than one year prior to the filing date of the Foster application. This is the necessary result it seems to me of the rationale of the majority that an applicant loses his right to a patent under section 102(b) if he fails to file his application for patent within a year after the invention became obvious.

What the Patent Office did here as to the Greene reference is consistent with its past position that the right to patent has not been lost in such situations. The Patent Office applies the reasoning of the majority *only* where the *issue* date of the patent is more than one year prior to the applicant's filing date. I am frankly unable to reconcile this anomaly (an example of which occurred in the Palmquist case as well) with the majority's fundamental proposition that there is an established policy of refusing patents for inventions which have become obvious more than a year prior to filing the application therefor. No such policy is expressed either in section 102(b) or section 103. On the contrary, what the courts and Congress have said is that, if and when under *certain express conditions* the invention becomes vested in the public more than one year prior to filing the application, then and *only* then is there a loss of right to patent. These conditions are stated in section 102 (b) and clearly require that *the invention* be *patented,* or

described in a printed publication or that it be *in public use* or *on sale.*[3]

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[3] I have found no case law which sanctions the forfeiture of the right to a patent except in those situations where the invention is "described" in a prior patent or printed publication or has gone into public use or on sale. This exception is explicitly stated in 35 U.S.C. 102(b) and is supported by such landmark cases as Bates v. Coe, 98 U.S. 31 (1878), and Parks v. Booth, 102 U.S. 96 (1880). In Bates v. Coe, the patent in suit related to a hand drill and screw cutter consisting of five elementary parts. The defense pleaded that the invention was old and the proofs consisted of several prior patents, each of which disclosed certain of the elementary parts of the patented combination. In rejecting this defense, the Court stated:

> "Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented combination." [98 U.S. at 48.]

While the primary issue in Bates v. Coe was whether the patentee was the first inventor, it is clear that the Court intended the stated principle to apply to the other statutory defenses as well.

In Parks v. Booth, the defendant offered proofs that the patentee was not the original and first inventor of the improvement patented, which proof consisted of twelve patents or specifications. The Court, in denying this defense, stated:

> "* * * Suffice it to say in that regard that all of them have been carefully examined to the extent of the means furnished by the transcript, and the court is of the opinion that no one of the documents is of a character to sustain the issue that the complainant is not the original and first inventor of the improvement."
>
> "Most or all of the inventions described in those publications bear more or less resemblance to that claimed by the complainant, and it may be that if it were allowable to test the

Second: Another example from which it can be seen that there is no such broad policy as stated by the majority, arises from a consideration of section 102(a) and what is

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validity of the invention in question by comparing the same with the whole as if embodied in a single exhibit, the evidence might be sufficient to support the views of the respondents in respect to the defence under consideration. Were that allowable it might well be suggested that the screen is found in one, the box in another, and the means to produce the lateral shake in a third, and so on to the end; but it would still be true that neither the same combination in its entirety nor the same mode of operation is described in any one of the patents or printed publications given in evidence."

"Attempt is scarcely made in argument to show that any one of these exhibits embodies the entire invention of the complainant, but it is insisted that every feature of the patented improvement is found in some one or more of those publications. Suppose that is so, still it is clear that such a concession, if made, could not benefit the respondents, unless they can be allowed to extend the same comparison to two or more exhibits, as they do not contend that the entire invention is superseded by any one of their exhibits."

"Where the thing patented is an entirety, consisting of a separate device or a single combination of old elements incapable of division or separate use, the respondent cannot make good the defence in question by proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another, and so on indefinitely, and from the whole or any given number expect the court to determine the issue of novelty adversely to the complainant. Bates v. Coe, 98 U.S. 31."

"Common justice forbids such a defence, as it would work a virtual repeal of so much of the Patent Act as gives to inventors the right to a patent consisting of old elements, where the combination itself is new and produces a new and useful result. New elements in such a patent are not required, and if such a defence were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defence consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to patent-rights." [102 U.S. at 103-04.]

meant by the term "known" as used therein. The case law indicates that for an invention to be "known," the "knowledge" of it must be of a very special kind and quality in order to be effective as an anticipation. This court held, in In re Schlittler, 43 CCPA 986, 234 F.2d 882, 110 USPQ 304, that such knowledge must be *available to the public and,* moreover that it must be knowledge of a *reduction to practice* of the invention against which it is cited.

It seems clear that this kind of knowledge—the kind required for anticipation under section 102(a)—certainly puts the invention in the possession of the public. And yet, section 102(b) does not base a *loss of right to patent* on such knowledge unless it has been "packaged," as it were, in a patent or a publication or in something which has gone into public use or on sale, prior to one year before the filing date of the application.

These examples seem to me to show the incorrectness of the majority position that there is a broad policy which demands a forfeiture of the right to patent in every case in which the public has possession of the invention for more than a year prior to filing of the application.

II. *Even if there were such a pervasive policy, it is an usurpation of the legislative function for this court to rewrite the statute.* In Sturges v. Crowninshield, 4 Wheat. (17 U.S.) 122 (1819), Chief Justice Marshall was moved to comment upon the need for a zealous judiciary to exercise restraint concerning inadequate legislative enactments. His eloquent words, written nearly a century and a half ago, are a remarkably current and valid summary of my views regarding the instant case; thus:

> "* * * although the spirit of an instrument, especially of a constitution, is to be respected not less than its letter, yet the spirit is to be collected chiefly from its words. It would be dangerous in the extreme, to infer from extrinsic circumstances, that a case for which the

words of an instrument expressly provide, shall be exempted from its operation. Where words conflict with each other, where the different clauses of an instrument bear upon each other, and would be inconsistent, unless the natural and common import of the words be varied, construction becomes necessary, and a departure from the obvious meaning of words, is justifiable. But if, in any case, the plain meaning of a provision, not contradicted by any other provision in the same instrument, is to be disregarded, *because we believe the framers of the instrument could not intend what they say,* it must be one in which the absurdity and injustice of applying the provision to the case, would be so monstrous, that all mankind would, without hesitation, unite in rejecting the application. This is certainly not such a case. * * *" [Emphasis added.]

Current validation of this point of view is supplied by Crawford's The Construction of Statutes at p. 249 which states:

"* * * if the language is unambiguous and the statute's meaning is clear the statute must be accorded the expressed meaning without deviation, since any departure would constitute an invasion of the province of the legislature by the judiciary."

The language of sections 102(b) and 103 is unambiguous, its meaning is clear, and I see no valid basis for deviation from it in deciding the present case.[4]

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[4] Webster's New International Dictionary (2d ed. 1954) defines "describe" in pertinent part as "2. To represent by words written or spoken * * * to state in detail the particulars of; * * * now esp., to give a mental image of; to depict verbally; as to *describe* a view, a person." The same source defines "obvious" as "2. Easily discovered, seen, or understood; plain; evident * * *."

Thus it would appear that the choice of language in section 102 (b) requiring, as it does, that *the invention* be *described,* has carried

Yet, the majority decision amounts to an interpretation of section 102(b) as though it contained the following underscored words:

> "A person shall be entitled to a patent unless—
>
> * * * (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country *or unless the invention became obvious* more than one year prior to the date of the application for patent in the United States * * *."

Thus, within the rationale of the majority opinion and its construction of section 102, it is no longer necessary for a patent or a publication to "describe" the invention to lay the basis for the loss of right to a patent under section 102(b). It is sufficient that a patent or a publication be found, or that some combination of the same can be put together after the applicant's date of invention and with the accuracy characteristic of perfect hindsight which make

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in to the statute the legal concepts expressed in Bates v. Coe and Parks v. Booth, supra note 3, i.e. that "anticipation" within the purview of section 102 requires that a description of the entire invention, not just some part of it, must be found in the patent or printed publication relied upon. This view is supported also by the express language of section 103, which is to apply when "the invention is not *identically disclosed or described* as set forth in section 102 * * *." (Emphasis added.) Under section 103 it is sufficient if the invention be "obvious" from the prior art. The section also includes the safeguard that this determination must be made "at the time the invention was made" and thus negates the "hindsight" and "piecemeal" reconstruction of the prior art which the Supreme Court recognized as a danger in Parks v. Booth. Quaere: If an invention is "obvious" under section 103 (although not "at the time the invention was made"), and the majority equates it with a "described" invention under section 102, do "obvious" and "described" now mean the same thing in the field of patent law?

the invention "obvious" more than one year prior to the date of filing the patent application. Thus, in addition to changing the wording of section 102(b) as above suggested, the majority must also intend to rewrite section 103 so that the phrase "at the time the invention was made" now is to be limited by a proviso which reduces this time to a period of one year prior to the filing of the application.

Thus it becomes pertinent to inquire whether such was the intent of the drafters of the Patent Act of 1952 or of the Congress in enacting it. While I think it was not, I speak here simply as a minority of one in expressing this point of view, however, I think these considerations support my position that such effects should be accomplished *only* by legislation, and not by a judicially imposed statutory construction.

A patent statute, like a patent claim, should be more than a mere "nose of wax which may be turned and twisted in any direction." Cf. White v. Dunbar, 119 U.S. 47, 51 (1886). Often a particularly loosely worded statutory provision can come very near to being all things to all people. But all statutes have an elastic limit, and stretching them beyond that point results in a flaccid collection of words, vulnerable and open to attack from all sides and a far cry from the legislative instrument that was intended. I am not persuaded by the majority opinion that this court should undertake by "interpretation" to rewrite key provisions of sections 102(b) and 103 according to judicial fiat. I think it is the Congress and not this court which should correct the oversight, if any, which may be present in the statute.

In the previous discussion, I have indicated something of the complexities of the problems here involved. Such problems lie peculiarly within the province of the Congress, where the instruments of investigation, public hearings and exhaustive debate can measure and determine the public

interest and state the proper public policy far more accurately than it can be done in this court.[5]

III. *Some logical problems and the undesirable consequences of the majority viewpoint.* In concluding, I shall comment on some of the undesirable consequences of today's decision. Others will undoubtedly perceive different problems, and the passage of time will surely create even more but in the following paragraphs I shall outline some of the matters that have been and are troubling me.

Consider what the majority has done in its opinion. One would have supposed, in view of the fact that the issue appears to be "loss of right to patent" under section 102 (b), that the majority would have decided this issue. Thus, one would have supposed the majority would first determine whether there was a right to a patent. I think the record is clear that Foster met every statutory standard to establish patentability of his invention on its merits. Clearly, the invention is new and unobvious under sections 102(a) and 103, respectively, since neither the Binder nor the Greene references were *in existence* at the time the invention was made. On the present record Foster *had* a right to

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[5] For a further exposition of these considerations, see the dissenting opinions of Justices Frankfurter and Harlan in Baker v. Carr, 369 U.S. 186, 266, 330 (1962).

With respect to the instant majority's characterization of section 102(b) as presenting "a sort of statute of limitations," see Eclipse Lumber Co. v. Iowa Loan & Trust Co., 38 F.2d 608, 610 (8th Cir. 1930):

> "While the general rule is that statutes of limitation are to be given a liberal construction as statutes of repose * * * [citing cases], they are not to be extended to cases not within their provisions. * * * " [Citing cases.]
>
> "A statute limiting the time to bring an action to enforce a mechanic's lien cannot be extended, by construction, to include within its terms the equitable action, authorized by section 3103, given to persons who can have no mechanic's liens. Where the language of a statute is plain, there is no room for construction. * * *" [Citing cases.]

a patent. Thus the only remaining question is whether he *lost* that right, under the provisions of section 102(b). And the majority's answer to this is (after overruling Palmquist): Yes, he lost his right to patent, since the Binder reference made the invention obvious more than a year before Foster filed his application.

Contrary to this simple approach and what might be supposed from these considerations, the majority opinion does not decide this issue. In overruling Palmquist, the majority gives lip service to the truism that "section 103 has nothing whatever to do" with the issue of loss of right to patent, but then proceeds to decide the case as one of obviousness using Binder as *prior art* under section 103, which it most emphatically is not, since it *did not exist* "at the time the invention was made."[6]

If the four members of the majority of this court cannot make clear which section of the statute or which underlying rationale they are applying, I hesitate to guess what an applicant in the future will face in the way of indefinite and evasive rejections from the Patent Office. Today's decision destroys any meaningful differences that may have existed in the past between sections 102(a) and (b) and section 103. This is evident from the way in which the majority opinion vacillates between sections 102 and 103 to support its affirmance of a rejection of the claims as "unpatentable over" the Binder reference.

Despite my past hopes that the Patent Office would adopt a policy of articulation regarding the statutory ground of rejection, it now seems clear that the majority is satisfied with a simple "unpatentable over" rejection. And since such a rejection can be for the reason that the claimed invention is old, or obvious, or for the reason that the right

[6] "The language of section 103 seems to leave no doubt that the date an applicant made an invention is the point of reference regardless of the existence of the statutory one-year bars. Such bars must be considered alone and not as part of the general knowledge to be imputed to the 'person having ordinary skill,' if later than said date of invention." Woodcock, "What is Prior Art?" in Dynamics of the Patent System 309 (1960).

to patent has been lost, the applicant is put in the position of guessing as to which ground is intended and arguing against each of these reasons, without knowing which one the Office really means or which one will be relied upon in the event of appeal.

The many powerful implications in the term "due process" apply to the patent law as well as they do to other fields. I am frankly unable to reconcile the procedural due process requirements of 35 U.S.C. 132 with the failure of the Patent Office here to comply with the notice requirements of this section.[7] Certainly one need look no further

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[7] A rejection so vaguely stated may well amount to a denial of the procedural safeguards provided in 35 U.S.C. 132. The affirmed rejection of claims as "unpatentable over" Binder may be a rejection for the reason that Foster's invention was "described" by Binder within the meaning of section 102; or that the statutory bar of section 102(b) has resulted in a loss of right to patent; or that the Foster invention was obvious in view of Binder under the conditions specified in section 103. A rejection so vaguely stated does not discharge the statutory duty imposed on the Commissioner of Patents by section 132. Certainly, it does not provide "such information [to the applicant] * * * as may be useful in judging of the propriety of continuing the prosecution of his application." It furnishes, instead, a constantly shifting ground so that the statutory basis for the rejection by the examiner may well differ from that of the Board of Appeals, even as it affirms the examiner's rejection. Under such circumstances what issue may then be assigned as error for appeal to this court under 35 U.S.C. 142 and be relied on by us for decision under 35 U.S.C. 144? The burden on an applicant is quite different in meeting rejections made under sections 102 and 103. A rejection under section 102 involves a comparison between the subject matter disclosed by the reference and that claimed by the applicant, in order to determine whether the claimed invention is "described" in the reference. See e.g., In re Sheppard, 52 CCPA 859, 339 F.2d 238, 144 USPQ 42. Section 103, on the other hand, requires consideration of the differences between the claimed invention and the prior art, for the purpose of determining whether the claimed subject matter as a whole would have been "obvious" to one of ordinary skill in the art. Thus, the issues arising under the two sections are vastly different and call for the production and introduction of quite different types of evidence.

than the majority opinion to see that the words "unpatentable over" do not impart such information as to enable an applicant to "judge of the propriety of continuing the prosecution of his application" as contemplated by section 132.[8]

Most disturbing of all is the fact that from this day forward obviousness under section 103 will be tested, *not as of the time the invention was made, but as of one year prior to the filing date of the application.*

Prior to the enactment of section 103, the determination of "invention" and the evaluation of the prior art relevant thereto always was made as of the time the invention was made. To now change the meaning of section 103 so that obviousness is tested as of one year prior to the filing date of the application, as it seems to me is required by the rationale of the majority, I think we should have some definite indication that such a change was within the contemplation of Congress in enacting section 103. Certainly, such a change should require more than an inaccurately stated principle of an alleged public policy to engraft the forfeiture provisions of section 102(b) onto section 103.

The majority in its construction of section 103 clearly embraces the historically rejected "hindsight" reconstruction of the prior art for all times except one year before the filing date of the application, a result I feel certain Congress intended to preclude by the very precise wording of section 103.

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[8] Another aspect of procedural due process which continues to concern me in the present case arises where the rejection appears now to be predicated upon section 103. The Commissioner of Patents has failed to provide a procedure by which an applicant can establish his date of invention as contemplated by section 103. Unless the date of invention be within one year from the filing date of the application, there is no remedy. If the date be within one year from the filing date there is a partial remedy under rule 131. By its context, however, rule 131 precludes an applicant from using it to establish a date of invention more than one year prior to his filing date.

A recent writer in observing that "hindsight" is one of our best-developed faculties"[9] has given current expression to the ancient observation recorded in Ecclesiastes 1:9, 10.[10] I had supposed, very naively as it now appears, that section 103 was bottomed on an awareness of the most human of all failings and that Congress had for this reason required that the determination of obviousness was to be made "at the time the invention was made." Instead, I now learn from the majority opinion that the clear language of this section does not mean what it says. Make no mistake about it, hindsight now is an accepted technique for rejection of an application under section 103 unless the effective date of the reference or combination of references is less than one year prior to the filing date of the application.

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[9] Eugene S. Ferguson, "The Origins of the Steam Engine," Scientific American, Vol. 210, pp. 98, 107 (January 1964).

[10] "9. The thing that hath been, it is that which shall be; and that which is done is that which shall be done: and there is no new thing under the sun.

"10. Is there anything whereof it may be said See, this is new? It hath been already of old time, which was before us."

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
WASHINGTON

July 1, 1965

Mr. Edward S. Irons
Irons, Birch, Swindler & McKie
1000 Conn. Ave.
D. C.

Re: Ex parte Foster
P. A. No. 7106

Dear Sir:

This is to advise you that the court today denied appellant's petition for rehearing in the above appeal.

The motion by appellant for stay of enforcement of decree of April 15, 1965, is granted and the certificate of the proceedings and decision of this Court and return of jurisdiction to the United States Patent Office of the application to which this appeal is directed is hereby withheld until fifteen days from the termination in the Supreme Court of the United States of any proceedings which may result from the filing of a petition for writ of certiorari in that court.

Very truly yours,

GEORGE E. HUTCHINSON
Clerk

a

CC: Mr. Clarence W. Moore

In the Matter of the Application of Folkers

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

No. 7393

Decided May 13, 1965

Appeal from the United States Patent Office

MARTIN, Judge.

The appealed claims of Karl Folkers' application[1] are directed to N-pantothenyl derivatives of two naturally-occurring amino acids, phenylalanine and histidine, and a method of preparing those derivatives by reacting the corresponding β-alanyl-amino acid with pantoyl lactone. While Folkers' disclosure shows, and he originally claimed, naturally-occurring amino acids in general, only the following four claims remain:

> "12. The process of preparing N-pantothenyl-dl-phenylalanine which comprises reacting N-(β-alanyl)-dl-phenylalanine with pantoyl lactone.
>
> 13. The process of preparing N-pantothenyl-histidine which comprises reacting N-(β-alanyl)-histidine with pantoyl lactone.
>
> 15. N-pantothenyl-dl-phenylalanine.
>
> 16. N-pantothenyl-histidine."

During prosecution, appellant removed a Brown et al. publication by a Rule 131 affidavit which was accepted by the Patent Office as showing a date of completion of the invention in the United States prior to April 1955, the publication date. A subsequently filed affidavit under Rule 132, apparently based on the identical factual showing as that given in the Rule 131 affidavit, carries appellant's date of

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[1] Application serial No. 862,031, titled "N-Pantothenyl Amino Acids and Processes for Preparing Them," filed December 28, 1959, which is a continuation of application serial No. 558,615, filed January 12, 1956.

completion of the invention back prior to April 1954, the date of the following sole reference relied on:

Baddiley et al. J. Chem. Soc. (London) 1954, pp. 2803-2812.

It is not controverted that Baddiley disclose a process of reacting pantolactone (pantoyl lactone) with β-alanyl amino acids. While Baddiley does not show the β-alanyl histidine or β-alanyl phenylalanine of the claims, other known naturally-occurring amino acids are shown.

The issue presented by the above facts is similar to that in In re Palmquist, 51 CCPA 839, 319 F.2d 552, 138 USPQ 234, the principal difference being that here the rejection involves only one reference. While appellant, in urging that Baddiley has been overcome as a reference, relies on Palmquist, and the solicitor seeks to distinguish that case on its facts, relying on In re Wenzel, 24 CCPA 1050, 88 F.2d 501, 33 USPQ 30, our decision here is governed by In re Foster, 52 CCPA ——, —— F.2d ——, 145 USPQ 166, in which we overruled Palmquist.

Whatever right to a patent appellant may have had at the time the invention was made, it has been lost within the meaning of section 102(b) *if,* indeed, the claimed invention *became* obvious to one of ordinary skill in this art through the publication of the reference more than one year before appellant filed his application.

It was the examiner's view that to be entitled to a patent, appellant must show that the substitution of other naturally-occurring amino acids for those listed in Baddiley would not be obvious. As the board noted, appellant has not controverted the examiner's statement that the claimed invention would be obvious to one of ordinary skill in this art upon viewing Baddiley. Rather, appellant filed an affidavit under Rule 132 in an attempt to remove Baddiley, thus precipitating the issue of whether Baddiley gave rise to a statutory bar. The board held that appellant

could not remove a publication whose date was more than a year prior to his effective U. S. filing date even though the disclosure therein did not identically disclose the claimed invention. The board also agreed with the examiner that the disclosure of the reference was sufficient to show that the claimed invention had been obvious to one of ordinary skill in the art for more than a year. Appellant's brief argues the issue of a statutory bar under section 102(b), which in the exact words of the statute is "loss of right to patent."

The respective dates of the Baddiley publication and of the filing of the parent application being more than a year apart, the time factor of the bar under section 102(b) is satisfied. Of course, if the publication did not describe the claimed invention or make the claimed invention obvious, then appellant could not have lost his right to a patent. However, we think that Baddiley, in showing processes and products which differ from those claimed only in the use of other known naturally-occurring amino acids, rendered the invention obvious at the time of its publication. That publication, although subsequent to the time appellant made the invention, brought the invention within the range of obviousness for more than a year prior to his filing date, and appellant, by virtue of section 102(b), has lost whatever right to patent he once may have had. The decision of the board is therefore *affirmed.*

WORLEY, Chief Judge, did not sit or participate in this decision.

SMITH, Judge, dissenting.

I cannot agree with the result reached in this case, for the reasons set forth in my dissenting opinion in In. re Foster, 51 CCPA ——, —— F.2d ——, 145 USPQ 166, 177-82.

Moreover, just as I cautioned in Foster, we are here confronted with a prime example of denial of procedural

due process to an applicant. The majority opinion fails to inform as to the precise ground of rejection in the present case, but proceeds as though the rejection were grounded on section 102(b). My study of the record has convinced me that no such rejection was ever made.

The examiner's answer states that all the claims were rejected "as being unpatentable over the Baddiley et al reference." This typically amorphous "unpatentable over" rejection tells us nothing, of course, with regard to any statutory reason for rejecting the claims. However, later in his answer the examiner says, "The applicant urges that a rejection under 35 U.S.C. 103 is not valid since he alleges that the subject matter of the claims was not obvious *at the time the invention was made* * * *." This statement makes it clear to me, as I am certain it did to the applicant, that the examiner was thinking in terms of section 103.

In sustaining the examiner's rejection, the Board of Appeals stated:

> "* * * Since the rejection over the Baddiley et al. article is based on 35 U.S.C. 103, appellant reasons that 35 U.S.C. 102(b) is not applicable. * * *"
>
> * * *
>
> "* * * Appellant has improperly interpretated [sic] 35 U.S.C. 103, however, since this section is based upon the prior art specified in Section 102. Thus, even if an invitation is not identically disclosed by a reference available under Section 102(b), a patent may still be refused over the same reference, under Section 103. * * *"

As can be seen from the above statements, the actual rejection made by the examiner and affirmed by the board was based upon section 103.

But instead of deciding the issue of "obviousness" at the time the invention was made, under section 103, the instant majority manufactures and decides an issue of *loss of right to patent under section 102(b).* How this can be done is an extremely puzzling question to contemplate, particularly in view of the statement in the Foster majority opinion that "Whether there has been a *loss of right to a patent* * * * is a distinct and separate issue, with which section 103 per se *has nothing whatever to do.*" (Latter emphasis added.)

Small wonder then that, as the majority opinion so candidly puts it "appellant has not controverted the examiner's statement that the claimed invention would be obvious to one of ordinary skill in this art upon viewing Baddiley." Appellant properly assumed, in view of the express language of section 103, that the obviousness of his claimed invention would be tested as of "the time the invention was made." And since Baddiley was not even *in existence* at that time, it could hardly be said that his invention was obvious thereover at that time. Even assuming that appellant accepted as correct the contention which has now been given the force of law by this court in Foster, he certainly was under no obligation to raise arguments and produce evidence directed to issues under section 101(b) [sic], *since,* I repeat, *there was no rejection on that basis.* Insofar as appellant was concerned, his Rule 132 affidavit had removed Baddiley as a reference *for purposes of section 103,* and since section 102(b) was not involved in any rejection, he had satisfied the statutory conditions for patentibility [sic].

Now appellant learns that what seems to have been a section 103 rejection is here sufficient to raise the issue of loss of right to patent under section 102(b). If I may be permitted an ad hominem, this is truly learning the hard way. For this is one case in which it is painfully clear that the appealed rejection did not provide the applicant "with such information * * * as may be useful in judging

of the propriety of continuing the prosecution of his application," to which he is entitled under 35 U.S.C. 132. In addition, the present majority seems to have little regard for the jurisdictional limits of this court, in that it now decides an issue that was never presented below. I find nothing in sections 141 through 146 of Title 35 which could, even by the most imaginative lawyer, be interpreted to permit this court to decide an appeal on the basis of section 102(b) when the only rejection was for obviousness under section 103.

To me it is unconscionable that an applicant can now receive a rejection from the Patent Office on one statutory ground, and then, on appeal from that rejection, receive a wholly new rejection from this court which is based on an entirely different statutory ground. I would reverse.

In the Matter of the Application of Hassler

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

No. 7318 Decided July 1, 1965

Appeal from the United States Patent Office

MARTIN, Judge.

The issues we must determine in this appeal are whether a newspaper article reporting progress of experiments by appellant and his coworkers is available as a reference, and if so, whether it, coupled with knowledge of the art either as generally known or as shown by certain patents, is sufficient to make the presently claimed invention obvious to one of ordinary skill in the art.

A newspaper article titled "Bulk Leaf Curing Method Ready for Farm Testing," appeared in "The News and Observer," Raleigh, North Carolina, on November 10, 1958. The article reports the results of a method of bulk curing tobacco regarded as "so promising that private manufacturers have now been encouraged to consider the development of commercial equipment and to aid in farm-scale testing." The method is stated to have been developed by agricultural engineers with the "N. C. Agricultural Experiment Station and USDA," and was "tested at the Oxford Research Station this summer" under a "cooperative tobacco curing program" headed by appellant, Dr. Francis J. Hassler.

Nineteen months later, on June 13, 1960, appellant Francis J. Hassler filed an application serial No. 35,499 for "Method and Apparatus for Bulk Curing Tobacco." A subsequent requirement for division by the Patent Office led to the instant application, serial No. 164,789, filed

January 8, 1962, titled the same as the parent, but the claims of which are restricted to the apparatus alone. As will be seen in greater detail below, the newspaper article disclosure corresponds in great part to the apparatus now claimed.

Appellant, in his main and reply brief, has taken two approaches to the article disclosure. First, it is urged that the article "merely identifies a bulk curing process which is being tested." Appellant notes that the Patent Office admits the article does not disclose all the claimed structure, nor does it disclose the nature of the curing process. It is argued that the article is merely "a disclosure of Dr. Hassler's early experimental work" which is now being used to preclude the patenting of "the ultimate commercial reality of those experiments." Appellant reasons that:

> "Since the News and Observer article was published at a time when the invention was in the experimental stage, appellant is entitled to the 'hospitality' accorded by law and the disclosure of the article should not be construed strictly against him."

In view of the fact that the article does not disclose all the claimed structure, appellant states that The News and Observer article "clearly does not constitute a statutory bar."

Appellant takes a second position, in major part relying on In re Palmquist, 51 CCPA 831, 319 F.2d 552, 138 USPQ 234, to the effect that the "board's rejection of the present claims is clearly based upon 35 USC 103," but "since the News and Observer article clearly is not prior to applicant's first date of invention, it is not a proper reference to be utilized in determining obviousness under 103."

The solicitor's brief points out that there is no evidence of record showing that the claimed invention had been *completed* prior to the publication of The News and

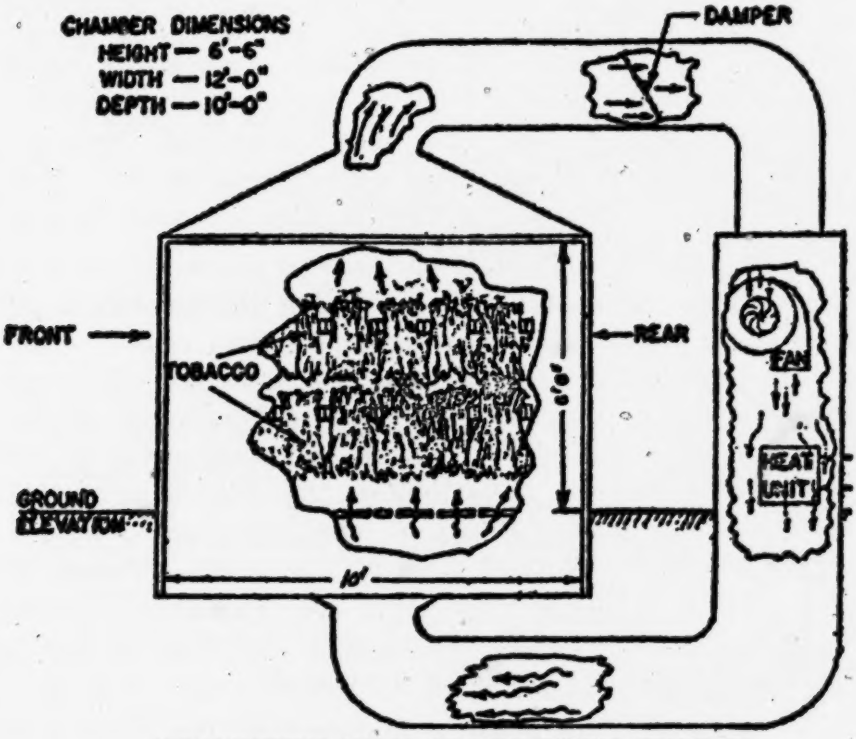
Observer article, thus the reliance on Palmquist was not well founded. The solicitor also points out that the two lines of argument are inconsistent, the appellant arguing on the one hand that the invention *had not been completed* prior to the article which therefore cannot be a barring anticipatory disclosure, and, on the other hand, that the invention *had been completed* prior to the publication, and in view of Palmquist the article was not an available reference for a section 103 rejection. Appellant's reply brief is devoted almost entirely to the argument based on Palmquist, urging that since The News and Observer article is a report of appellant's own invention it is both absurd and unnecessary to require him to swear behind it, citing M.P.E.P. 715.01(c).

We think the contradiction between the two lines of appellant's argument is more apparent than real. As we see it, appellant is arguing that The News and Observer article is not a complete disclosure, and so much of the invention as was disclosed therein was made prior to the publication thereof. Nevertheless, the line of argument concerning the unavailability of The News and Observer article has been rendered moot by our recent decision in In re Foster, 52 CCPA ——, —— F.2d ——, 145 USPQ 166, in which that aspect of In re Palmquist relied on by appellant for support was explicitly overruled.

We agree with the board's holding that The News and Observer article is a valid reference under 35 USC 102(b) *for what is disclosed therein,* since it was available to the public for more than a year prior to applicant's filing date. In re Ruscetta, 45 CCPA 968, 255 F.2d 687, 118 USPQ 101; In re Foster, *supra.* The publication is not removed as a reference merely because it discloses appellant's own invention, or an early stage of that invention, and the publication, having been available to the public for more than a year, may not be overcome by a showing of invention prior to the publication date. The question then is to

determine what is disclosed therein and whether that disclosure, taken with prior art, renders the claimed invention obvious to one of ordinary skill in the art.

The News and Observer article consists of text, three photographs, and a diagram, the last being reproduced here:



EXPERIMENTAL MODEL OF BULK CURING CHAMBER.

The pertinent part of the article text states:

"Bulk Leaf Curing Method Ready For Farm Testing"

"By Tom Byrd."

* * *

"More Uniform Leaf"

"'It [the method] also has the potential for producing a more uniform leaf,' Dr. Hassler said, 'which will make grading easier.'"

"A special barn is required to bulk-cure tobacco. However, the leaf is prepared for market the same way as conventionally-cured tobacco."

* * *

"In this new bulk-curing process tobacco is placed in frames by the armful, rather than tied on sticks three or four leaves at a time."

"Two men can frame the tobacco and place it in the barn as rapidly as at least four men can prime it from the field. Under present barning methods, about 10 barn hands are needed to keep up with four primers."

"Laboratory tests show there are no significant chemical differences in the bulk-cured and conventionally-cured tobacco. Representative samples of tobacco bulk-cured at the Oxford station last summer averaged $62 per hundred on the open market."

* * *

"New Approach"

* * *

" 'Throughout our work,' Dr. Hassler continued, 'we have recognized that the present curing method is a major factor in characterizing our flue-cured tobacco. Therefore, in the research and development of this new process we have been very careful to compare those qualities that characterize our flue-cured tobacco.' "

The first photograph shows a worker placing tobacco leaves in a trough-like loading bin. A horizontal bar having numerous long spikes extending downward therefrom is disposed above the tobacco in the loading bin. The caption states:

"Bill Johnson places tobacco into frames for curing. Spikes at top of frame are pushed through tobacco to hold it in place."

The second photograph shows two workers lifting the special "frame" which holds the tobacco, and is captioned:

"Wiley Henson (left) and Rupert Watkins move a frame of tobacco from loading racks to curing barn. Frame holds 10-12 sticks."

The third photograph shows the interior of the curing chamber. Two tiers of the special frames which hold the tobacco are shown therein, one end of each frame being supported by posts in the center of the barn, while the other end of each frame is apparently supported on the walls visible at the edges of the photo. The caption states:

> "INTERIOR OF BARN used for bulk curing is shown here. Hot air moves up through the floor and through the frames of tobacco. Two-thirds as much tobacco could be cured in this chamber as in a 16 x 16 foot barn."

The disclosure of the appealed application will be readily apparent from certain of the drawings:

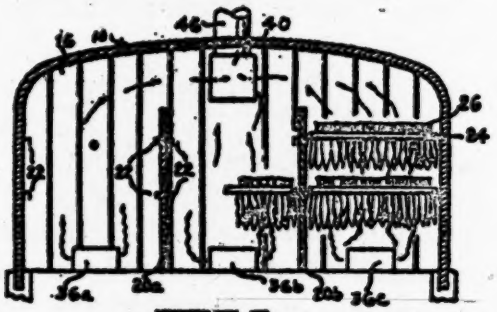


FIG. 3

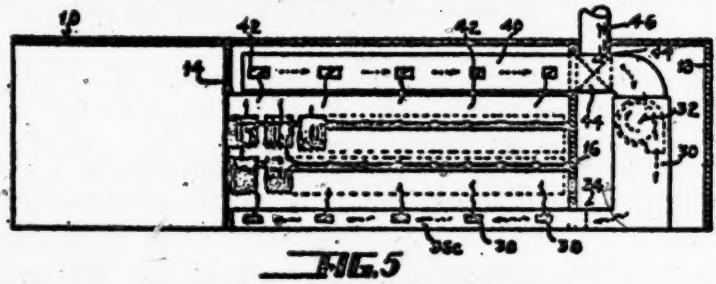


FIG. 5

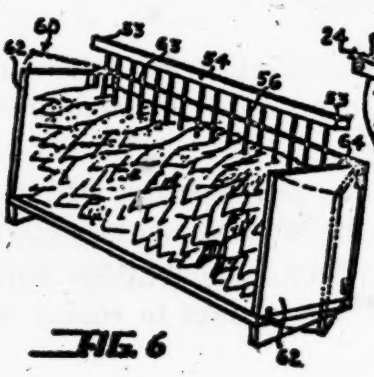


FIG. 6

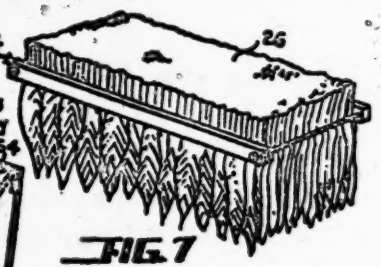


FIG. 7

Fig. 5 shows a longitudinal section view of a curing barn, and Fig. 3 shows a cross-sectional view through the drying chamber portion. Referring to Fig. 5, furnace 30 heats air which is moved from the furnace room (delineated by the area between right end wall 18 and partition 16) by a blower 32 through duct 36c into the drying chamber (delineated by the area between left end wall 14 and partition 16). Hot air leaving ports 38 passes through the tobacco 26 (Fig. 3) racked in special frames 24. Dimensions of the frames, barn partitioning (i.e. consider Fig. 3, partitions 20a, 20b, and Fig. 5, walls 14, 16), and close leaf packing are "* * * such as to force the circulated air to flow between the bulked tobacco leaves." The air then exits via upper duct 40. Element 44 is a damper and outlet duct 46 communicates to the outside atmosphere. By adjustment of the damper, varying amounts of fresh air may be admitted to the heating system, and, if desired, "* * * duct 46 may be closed, such that the air within the system is recirculated without addition of fresh air." A particular cycle of temperature and humidity throughout a 3-stage drying process is disclosed.

The apparatus used in the process of loading the frames or racks with tobacco leaves to be dried is illustrated in Figs. 6 and 7. The loading bin has an open top and open side. Tobacco leaves are placed butt end first into the bin and a frame or rack side-member 54 is pressed downwardly to force the spikes 56 through the tobacco leaves. A second side-member (not shown) receives the spikes, and the two side-members are fastened together by end rods (Fig. 7). The loading bin end panels 62 (Fig. 6) are then swung away, and the completed frame or rack of tobacco is lifted out and positioned in the curing barn, being slid thereinto on rails 22 (Fig. 3), mounted on the partitions 20a, and 20b, and the sidewalls.

Figs. 6 and 7 correspond to the first two photographs of The News and Observer article, with the exception that

workers are seen in the photos manipulating the bin and frame or rack of tobacco.

Appellant's claim 9, representative of claims 9-15 on appeal, reads as follows except that the breakdown, numbering and emphasis are ours:

9. Apparatus for bulk curing tobacco leaves comprising

A. a plurality of *tobacco leaf supporting racks* [also called "frames" by appellant], each of said racks including sections movable apart to receive a batch of tobacco leaves in bulk form with the flat surfaces thereof disposed generally in one direction and with at least a substantial portion of the flat surfaces of the leaves generally parallel and movable together to support the batch of leaves in a compressed state, the sections of each rack when together including means for continuously peripherally confining the batch of leaves along a pair of straight parallel first sides and a pair of straight parallel second sides extending perpendicular to said first sides and spike means extending within the peripheral confining means between a pair of parallel sides thereof in piercing relation to the batch of leaves in a direction generally perpendicular to the parallel flat surfaces thereof so as to provide interior support for the leaves while permitting flow of air between the leaves within the confining means in the direction of disposition of the flat surfaces thereof,

B. *a barn structure* for supporting said plurality of racks when the sections thereof are together in supporting relation to respective batches of tobacco leaves, said barn structure including

1. spaced pairs of elongated horizontally extending *rail means,*

each pair of rail means providing substantially continuous upwardly facing supporting surfaces disposed generally in the same horizontal plane, said rail means being included within said barn structure with the supporting surfaces of each pair of rail means spaced apart a distance sufficient to engage and support a group of said racks in side-by-side relation with the first sides of the peripheral confining means of said racks extending horizontally adjacent said supporting surfaces and with adjacent second sides of adjacent racks extending horizontally therebetween in substantially abutting relation,

2. said barn structure including *vertical wall means* extending upwardly from *a floor and a roof supported by said vertical wall* means above said floor, said rail means being disposed within said vertical wall means at positions between said floor and said roof, said *vertical wall means defining with said roof and said floor upper and lower air spaces* disposed respectively above and below said rail means,

said vertical wall means including *closable door means* adjacent one end of said pairs of rail means openable to provide access completely horizontally across the associatd supporting surfaces to permit said groups of leaf supporting racks to be moved into said side-by-side relation by horizontal sliding movement along the associated supporting surfaces, said barn structure and the vertical wall means thereof with said door means closed confining direct vertical communication between said air spaces solely to the rack occupying spaces defined between the pairs of supporting surfaces of each of said pair of rail means,

3. *fan means* having a suction side and a pressure side for creating a forced flow of air,

4. *means* for communicating the pressure and suction sides of said fan means with said air spaces respectively so as *to establish a circulatory path of air flow* including generally vertical flow of air through said rack occupying air spaces,

5. *means for heating* the air flowing in said path,

6. and *means for introducing* controlled amounts of atmospheric air into *and exhausting controlled amounts of air* from the air flowing in said path,

the capacity of said fan means, said heating means and said air introducing and exhausting means being such that sufficient air of a *desired temperature and moisture content* can be forced generally vertically through said rack occupying spaces to effect a yellowing of the leaves supported by said racks, a subsequent drying thereof, and a final ordering of the leaves.

Claim 10 depends from claim 9 and specifies two tiers of rail means to support the frames or racks of tobacco. Claim 11 also depends from claim 9 and specifies the two tiers of rails and a pair of inner partitions in the curing chamber. Claim 12 depends from claim 11 and additionally specifies walls defining a furnace room adjacent the curing chamber. Claim 13 depends from claim 9 and specifies a humidifier "for introducing a controlled amount of moisture" into the circulating air. Claims 14 and 15 are similar to claim 12, in independent form, with claim 15 additionally specifying separate dampers for each lower air duct. There are no allowed claims.

We deem it unnecessary to set forth any further analysis of how The News and Observer article was applied to the claims. It will be evident from comparison of the diagram reproduced above with the elements of the claim that there are but few claim elements lacking. Because some claim limitations are missing from the article, the examiner and

board evidently viewed the loss of right to involve the question of obviousness. Both appellant and the solicitor in their briefs similarly characterize that aspect of the issue. To supply the missing elements, the Board of Appeals has taken "judicial notice" of several elements and has also relied on secondary references.

In particular, the board took "judicial notice of dampers," and stated that it is "common practice in air conditioning systems to provide means for introducing * * * and exhausting controlled amounts of air from the system." The board also took judicial notice that it is common to have a separate furnace room in a building. The board relied on the following references:

Stevens et al.	2,752,096	June 26, 1956
Vickers	2,808,283	Oct. 1, 1957

Stevens et al. is directed to a tobacco curer employing the circulation of heated air. The apparatus disclosed comprises a small furnace placed on the floor in a conventional tobacco barn. Horizontal air outlet conduits extend from the top of the furnace to various parts of the barn. A second air conduit, containing several air inlets, is placed in the peak of the barn. That conduit extends downwardly at one end of the barn, along the floor through a blower and into the furnace. By means of this system, air is heated and circulated through the outlet conduits throughout the entire barn and may be returned by way of the inlet conduits.

The teaching in Stevens et al. relied on by the board pertains to the disclosure of a means for supplying moisture to the air, which means consists of a waterline terminating in a spray nozzle which is located in the air path between the furnace and the horizontal air outlet conduits. Stevens et al. states:

> "* * * The purpose of this construction is to introduce very moist air into the tobacco barn after the tobacco

has been cured. This restores enough moisture to the tobacco so that it may be handled without crumbling."

While Stevens et al. discloses using that humidifying device *after* the tobacco has been cured, we are here concerned with structure, not method. We do not see any difference in the "humidifier" means as called for in claim 13 and that shown in Stevens et al. Stevens et al. also quite clearly shows the humidifier in the same apparatus context, that of an air circulating tobacco curing apparatus. In view of that teaching of Stevens et al., it would be obvious to provide air humidifying means in conjunction with the tobacco curing apparatus claimed.

It was unnecessary to take judicial notice of dampers as recited in the claims since The News and Observer article shows damper means on the upper exhaust conduit. Further, Stevens et al. shows (in their Fig. 1) a T-junction in the air conduit leading from the peak of the barn down to the furnace. The T-junction leads a short distance through the barn wall to the outside atmosphere, and at the outer end thereof appears a conventional hinged flap-type closure. That conduit and hinged closure appears to be a type of conventional damper, and its function is well known.

Also we are in complete agreement with the board that providing doors for the curing chamber would be obvious; though not shown in The News and Observer article, such structure is inherent.

Vickers was cited for the purpose of showing a frame in which the tobacco leaves are impaled for hanging in a curing barn. The rejection alternatively relied on Vickers for that showing, in the event that the first two photographs of The News and Observer were not considered to show all the detailed structure claimed. Suffice it to say that the difference between Vickers' tobacco curing stick and that claimed is one of capacity. Vickers intends his tine-

type stick to replace the traditional stick without an increase in capacity of tobacco secured thereon. An increase in capacity is not reflected structurally in the claim, but in any event is clearly evident from the disclosure in The News and Observer, in which each frame is said to hold "10 to 12 sticks" of tobacco. Any details of a frame which would function as does that claimed, if not shown in The News and Observer article, are quite well supplied by equivalent structure in Vickers.

Viewing the record as a whole, we are satisfied that the board did not err in its application of the pertinent art to the claims. In view of the knowledge which one of ordinary skill in this art possesses, as evidenced by the patents to Vickers and Stevens et al., The News and Observer article would make the subject matter presently claimed entirely obvious. Since the claimed invention has been obvious to the public for more than a year prior to appellant's filing date, we hold appellant to have lost his right to patent under 35 USC 102(b). In re Foster, *supra*.

In view of the foregoing, the decision of the board is *affirmed*.

SMITH, Judge, concurring.

In my opinion, the publication in the *Raleigh News and Observer* on November 10, 1958, more than one year prior to appellant's filing date, is an enabling disclosure which so described the invention here claimed that one of ordinary skill in the tobacco flue-curing art can be said to have had possession of the invention at that time. The additional references cited are at best evidence of what one of ordinary skill in this art would be expected to know.

In Cohn v. United States Corset Co., 93 U.S. 366, 377 (1876), the Court stated the guiding principle which I think is applicable here:

> "* * * the evidence shows that the Johnson *specification, in connection with the known state of the art at the time when it was filed and published, was sufficient to enable one skilled in the art* of corset-making and in the use of the jacquard *to make the patented corset.* * * *" [Emphasis added.]

See also In re Sheppard, 52 CCPA 859, 339 F. 2d 238, 144 USPQ 42; In re LeGrice, 49 CCPA 1124, 301 F. 2d 929, 133 USPQ 365. Cf. In re Wenzel, 24 CCPA 1050, 88 F. 2d 501, 33 USPQ 30.

Appellant urges that since the publication describes his own experimental work, it is clear that his date of invention is earlier than the publication date. While this undoubtedly is true, no exceptions are provided under 102(b) when, as here, the invention was *described* in the printed publication.

Appellant urges that the publication should be "strictly construed" to the end that since the invention was in an experimental stage on the date of publication, appellant is entitled to the "hospitality" accorded by law to encourage experimentation and further development of an invention before an application is filed thereon.

Congress has seen fit to fix the time period for such "hospitality" at one year from the date of a publication describing the invention and we can do nothing about it except to review and compare the invention claimed and the invention described in the publication.

Appellant urges that when this is done,

> "There are two fundamental reasons why the News and Observer article does not meet such strict tests. First, the article does not clearly disclose all of the structural limitations set forth in the claims. Second, the article is completely lacking in any disclosure of how a complete structure *could be used to obtain the results alluded to.* So long as the article includes these deficiencies the invention has not been placed in the possession of the public, nor would one skilled in the art be enabled to make *and use* the structure or to practice the invention."

I have reviewed the *News and Observer* publication in view of appellant's position and have concluded that it does convey to one of ordinary skill in the tobacco flue-curing art a sufficient disclosure of the invention to permit it to be put into practical operation. Hence, it seems to me that it meets the requirements of a publication spelled out in In re LeGrice, *supra,* and the cases therein discussed.

I do not, therefore, regard this case as involving a rejection under 35 USC 103 and I agree fully with the statement in appellant's brief that:

> "* * * It can be stated unequivocally that if the present claims are held to be unpatentable, it is not because Dr. Hassler failed to make an invention, but solely because Dr. Hassler was not sufficiently diligent in filing his application."

To the extent the resolution of the issue here requires a determination of patentability under section 103, as the

majority seems to indicate, I would *reverse* for the reasons more fully elaborated in my dissenting opinion in In re Foster, 52 CCPA ——, —— F. 2d ——, 145 USPQ 166. However, it does not seem to me that this issue is here presented since the publication relied upon "describes" the claimed invention within the meaning of section 102(b) and the many decisions which have interpreted it. I therefore concur in the result reached but do so solely on this basis.

IN THE UNITED STATES PATENT OFFICE

Decision of Board of Appeals, May 29, 1962

Ex Parte Frederick C. Foster

Before Asp, Examiner-in-Chief, and Behrens and Marmelstein, Acting Examiner-in-Chief.

Marmelstein, Acting Examiner-in-Chief.

This is an appeal from the final rejection of claims 12, 13, 17, 18, 22, 23, 25, 26 and 28 and from the refusal of the Examiner to allow claims 29, 30, 32, 33, 34, 35, 36, 39 and 40 which were added after the final rejection. Claims 14, 16, 19, 20, 21, 24 and 27 stand withdrawn from further consideration under Rule 142(b) as not readable on the elected species. No claims have been allowed.

Claim 12 is illustrative and reads as follows:

> 12. A synthetic polymer selected from the group consisting of rubbery homopolymers of butadiene-1,3 and rubbery copolymers of butadiene-1,3 and styrene; said synthetic polymer being characterized by a *cis* 1,4-structure of at least 23% and a 1,2-structure not in excess of 15% of the polymeric butadiene present in the polymer.

The single reference relied on is:

Binder, "Ind. & Eng. Chem.," **46**, pages 1727 to 1730 (1954)

Reference added by us:

Greene	2,762,790	Sept. 11, 1956
		(filed Dec. 26, 1952)

The claimed invention relates to elastomeric rubbery polymers of butadiene and copolymers of butadiene and styrene based upon the fact that the polymers of the invention possess a substantially increased amount of *cis* 1,4- and a decreased amount of 1.2-structure. The polymers are said to have outstandingly good properties at low temperatures.

The Binder article is adequately described by the Examiner on pages 2 and 3 of his answer.

All the appealed claims have been rejected as unpatentable over the Binder article, the Examiner setting forth his position as follows:

> "Claims 12, 13, 17, 18, 22, 23, 25, 26, 28-30, 32-36, 39 and 40 are rejected as unpatentable over Binder which discloses butadiene polymers having a cis 1,4; trans 1,4; and 1,2 structural content substantially the same as that defined by the claims. For example, claims 12, 13, 29, 30, 34, 35, 36, 39 and 40 which read on a butadiene polymer having at least 23% cis 1,4 structure and not exceeding 15% 1,2 structure is unpatentable over the disclosure in Table V which discloses a butadiene polymer having 22.4% cis 1-4 and wherein 17.1% is of the 1,2- structure. Moreover, claims 22, 23, 25, 26 and 28 which read upon a butadiene polymer characterized by possessing a 100% cis 1,4 or 100% trans 1,4 structure are deemed unpatentable over the disclosure on page 1730 under conclusions. The Examiner is cognizant that the properties of the polymers defined by the claims differ from those disclosed by the reference; however, these differences are recognized as being differences of degree and not of kind. Lastly, it should be noted that the vulcanization of a polybutadiene is a conventional expedient apparent to those skilled in the art. Hence the patentability of claims 17 and 18, a by product of said vulcanization process, is dependent upon the patentability of claims 12 and 13 and accordingly, are subject to the rejection."

After full and careful consideration of the Binder article and all of appellant's arguments presented in his briefs and at the hearing together with the affidavits of record, we are of the opinion that the rejection of all the claims on the Binder reference should be sustained.

Binder teaches the desirability of obtaining a butadiene polymer having a high *cis*-1,4-configuration content and

therefore the claims to such products cannot be considered as defining patentable novelty. Although Binder does name a 100% *cis*-1,4 polybutadiene and therefore may be deemed to be a disclosure of said polymer, thus meeting the polymers defined by the appealed claims according to *In re* Von Bramer et al., 29 CCPA 1018, 1942 C. D. 462, 542 O. G. 183, 127 F. (2d) 149, we particularly consider the claims, calling for the polymers being of at least 23% *cis*-1,4 structure and not in excess of 15% 1,2-structure, to be unpatentable over Binder's disclosure of such polymers disclosed in Table V having a 22.4% *cis*-1,4 structure and wherein 17.1% is of the 1,2-structure.

For the purpose of establishing the criticality of the recited limitations in the claims on the content of *cis*-1,4- and 1,2-structures, affidavits have been filed for the purpose of showing that the differences between the claimed polymers and those disclosed by Binder are of kind rather than of degree as held by the Examiner.

As to the affidavits, the Examiner states that it is well known that natural rubber is of high *cis*-1,4 content and has the properties of low hysteresis, tensile strength, ultimate elongation and that the art is well aware that by increasing the amount of *cis*-1,4 content of a polybutadiene polymer, the properties of the synthetic polymer will resemble those of natural rubber. It is contended that because of the foregoing, the affidavits do not show that the claimed polymers have any properties that one skilled in the art would not expect them to possess. It is the Examiner's position that the result achieved by appellant does not represent a difference in kind over the prior art or *that the results are unforeseeable.*

We have examined the affidavits and do not think that they can be considered as effective in establishing criticality of appellant's polymers over those disclosed by Binder. Referring to the Johnson affidavit filed May 26, 1961, under item 16 it is stated that Johnson caused to be duplicated eleven different polymers and copolymers identified in the Binder article by the indicated designations. The one

closest to those claimed is the polymer designated 1140 which according to the reference has 22.4% *cis*-1,4- and 17.1% 1,2-structure. The other of the polymers are of various content of *cis*-1,4 structure less than 22.4% and farther removed from the claimed *cis*-1,4 structure content. As to the polymers other than 1140 of the references, it is indicated that the polymers are solid similarly to those of appellant whereas as to polymer 1140 it is shown that it was too fluid and sticky to test. It seems strange that as to the polymer nearest to those of the claims, appellant's reproduction produced a non-solid polymer whereas as to all the others of the reference that are reproduced and which are farther removed from those of the claims, solid polymers were obtained. There is also another more important objection to the 1140 polymer reproduced by appellant. The reproduced polymer shown as having 19.2% *cis*-1,4- and 19.1% 1,2-structure is even farther removed from those claimed. Under the circumstances we cannot accept appellant's showing as being a comparison of the closest polymers of those claimed and of the reference. We thus have not been convinced that there is a difference in kind and not of degree between the *cis*-1,4 polymers of 23% of the claims and the 22.4% of the reference. While appellant has achieved a particularly desirable product, we cannot agree that this product represents a difference in kind over the prior art, or that the results are unforeseeable.

We have taken note of the numerous publications, copies of which have been filed herein, but we cannot see that they serve to establish a difference in kind of the claimed polymers over those of the Binder reference. As to commercial success which is indicated by the publication exhibits, it is unnecessary to cite any decisions in support of the doctrine that commercial success is of no consideration when there is no doubt as to lack of invention over the prior art.

Claims 39 and 40 have been further rejected as not properly defining the alleged invention.

As to claim 39, the Examiner has held that the recitation ". . . not less than 2.3% . . ." is not adequately supported within the specification. We will not sustain the rejection as to this claim. We consider the disclosure of this lower limit of the 1,2 structure in Example 13 as adequate support therefor.

As to claim 40, the Examiner has held that there is no basis in the specification for terms such as "ionic catalyst" and "nonaqueous system." As to the remaining quoted expressions, they are not present in claim 40. As to "ionic catalyst," this term does not appear to have been used by appellant in describing the catalysts used in his process of producing the claimed polymers. Appellant's catalysts are "ionic" but he has disclosed a very limited number and kind thereof. We are of the opinion that the term in question is unsupported as to breadth thereof. As to "nonaqueous system," we agree with the Examiner that this term is too broad and insufficiently descriptive. In addition, the Examiner notes that claim 40 is improper inasmuch as product claims described by characteristics and product by process claims concurrently presented are inconsistent. Claim 29, the Examiner states, makes it more than apparent that the product can be described in ways other than by its mode of preparation. We will sustain this rejection as to claim 40.

The patent to Greene, the citation of which is given above and which has been added by us, discloses in column 1, lines 30 to 35, the polymerization of aliphatic conjugated diolefins, particularly 1,3-butadiene, to high molecular weight, solid, elastic polymers characterized by the presence of a predominant proportion of 1,4-linked, cis-configurational monomer units. Under Example 1, column 8, lines 47 to 56, the solid polybutadiene product is said to contain 80% 1,4-linked butadiene units of which 62.5% has the cis-configuration. This calculates to 50% of the polymer as of the *cis*-1,4-configuration. It is our opinion that all the appealed claims are unpatentable over the noted disclosures of the Greene patent and we therefore herewith

reject all the appealed claims on the Greene patent under the provisions of Rule 196(b).

As indicated above in connection with the rejection of claims 39 and 40 as not properly pointing out the invention, the Examiner has remarked that it is improper as being inconsistent for product claims to be described by characteristics and product by process claims presented concurrently. In addition we deem it necessary to point out that when product claims are drawn in terms of the process, even if proper as an exception to the general rule, critical steps of the process may not be omitted in the description of the process. Claims 30, 32, 33, 36 and 40 appear to depend for patentability upon process limitations or may be considered as product by process claims and it is clear that critical steps or limitations as to the conditions of the process have been omitted. *In re* McKee, 25 CCPA 1011; 1938 C. D. 425; 495 O. G. 711; 95 F. (2d) 267. Product claims depending for patentability on process should recite all necessary steps to obtain product. *Ex parte* Green, 69 USPQ 620. Under the provisions of Rule 196(b), we herewith enter a rejection of claims 30, 32, 33, 36 and 40 as being improper product by process claims in accordance with the foregoing.

The decision of the Examiner is affirmed. Rejections under the provisions of Rule 196(b) have been added.

Any request for rehearing or reconsideration or modification of this decision by the Board of Appeals based upon the same record must be filed within thirty days from the date of the decision. (Rule 197). Should appellant elect to have further prosecution before the Primary Examiner in response to the new rejection under Rule 196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire *sixty days* from the date of decision.

IN THE UNITED STATES PATENT OFFICE

Decision of Board of Appeals, September 17, 1962

Ex Parte Frederick C. Foster

On Reconsideration

Before Asp, Examiner-in-Chief, and Behrens and Marmelstein, Acting Examiners-in-Chief.

Marmelstein, Acting Examiner-in-Chief.

Appellant requests reconsideration of our decision of May 29, 1962 in which we affirmed the rejection of all the claims in the case and wherein we also entered new rejections under the provisions of Rule 196 (b).

With respect to the rejection of all the claims on the Greene patent upon which we rejected the claims under the provisions of Rule 196 (b), appellant has filed affidavits under the provisions of Rule 131 in order to antedate this patent and thereby to dispose of it as a reference. We have examined the Rule 131 affidavits and all the exhibits forming part thereof and find them acceptable to dispose of the Greene patent and we accordingly herewith withdraw the Greene patent as a reference against the appealed claims.

The affidavits under Rule 132 that have been filed against the Greene patent have not been considered, not only because this patent has been disposed of under Rule 131, but also and particularly because they can be of no pertinency under the facts of this case. The invention being claimed herein resides in a product and not in a process for the production thereof. The reference discloses the product and it is of no moment whether the disclosed methods for producing it are operative or not.

The Rule 132 affidavits filed with the request for reconsideration with respect to the rejection on the Binder reference have not been considered. The reconsideration requested must be upon the record. Rule 197.

We have reconsidered the rejection of the claims on the Binder reference and we remain of the opinion that it is

sound. The Binder reference does disclose a 100% *cis*-1,4 polybutadiene and also a composition (polymer 1140) very close to the 23% *cis*-1,4 claimed content polybutadiene. Appellant relies upon *In re LeGrice*, 49 CCPA ————; 301 F. (2d) 929; 133 USPQ 365, in arguing against the Binder reference. We have reviewed this case and find therein no basis to indicate that our holding of unpatentability of the claims on Binder is improper. We think that the instant case is similar to the facts in the case of Shell Development Co. v. Watson (citation in the quotation below) which the court in the LeGrice case said properly supported facts such as here involved. The following is quoted from the LeGrice case (page 377 USPQ citation):

> "In Shell Development Co. v. Watson, 149 F. Supp. 279, 113 USPQ 265, 268, affirmed 102 U. S. App. D. C. 297, 252 F. 2d 861, 116 USPQ 428, which the Patent Office further cites to support its position, the court relied on the Merck case and stated further:
>
> A clear description in a prior publication is all that is necessary under the law to bar a subsequent inventor from obtaining a patent on the identical thing. In other words, a prior publication, in order to defeat a patent, need only exhibit the thing claimed in such an intelligible manner as to *enable persons skilled in the art to which the invention is related, to comprehend* it. Defendant's refusal to grant the claim sought here based upon the Ring Index publication was proper for the Court holds that the name and the structural formula contained in the Ring Index publication constitutes a sufficient description to anticipate. Plaintiff's claim 13 is clearly described in the publication within the meaning of the statutory language. I find for the defendant. (Emphasis ours.)
>
> The court in the Shell case cited the Merck case as its authority. It is therefore in this light that we must construe the court's use of the word *comprehend*. So construed, the Shell case holds that the publication *in*

> *the light of the knowledge possessed by those skilled in the art* was sufficient to bar the grant of a patent. We do not find this to be inconsistent with our holding based on contrary facts in the case at bar."

As for the formal rejections of the claims, appellant has advanced nothing that convinces us that that part of our decision is in error.

Our decision has been reconsidered. The rejection of all the claims on the Greene patent is withdrawn. The decision in all other respects remains unchanged.

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In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

IN THE MATTER OF THE APPLICATION OF FREDERICK C. FOSTER, PETITIONER

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

Both the original decision of the Patent Office Board of Appeals (App. 65a–70a)[1] and its decision on reconsideration (App. 71a–73a) are unreported. The opinion of the United States Court of Customs and Patent Appeals is reported at 343 F. 2d 980 (App. 5a–41a).

JURISDICTION

The opinion of the Court of Customs and Patent Appeals was entered April 15, 1965 (App. 5a). A timely petition for rehearing or reconsideration was denied on July 1, 1965 (App. 42a). The petition for a writ of certiorari was filed July 14, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

[1] "App." refers to the Appendix filed as a separate document with the Petition. "Pet." refers to the Petition.

QUESTION PRESENTED

Section 103 of the Patent Act provides, as a condition of patentability, that an invention is not patentable if, at the time it was made, it was "obvious" to "one skill[ed] in the art." Where there is a delay between the invention and the patent application, Section 102(b) of the Patent Act (the so-called "time-bar" provision) provides in addition that the right to a patent is lost if the invention "was patented or described in a printed publication * * * more than one year prior to the date of application for patent * * *." The question presented is whether this time-bar provision applies where a printed publication, subsequent to the invention but more than one year prior to the patent application, does not identically disclose the invention upon which a patent is later applied for but renders it obvious to one skilled in the art.

STATUTES INVOLVED

35 U.S.C. 102, in relevant part, provides:

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, * * *

35 U.S.C. 103 provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. 132 provides:

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

35 U.S.C. 144 provides:

> The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall

be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

STATEMENT

Petitioner filed his patent application for "Butadiene Polymers and Copolymers Thereof"[2] on August 21, 1956 (App. 5a). The date of invention was prior to December 26, 1952 (App. 14a). The only prior art reference relevant to petitioner's application was an article by Binder in the magazine "Industrial and Engineering Chemistry" (Vol. 46, No. 8, pp. 1727–1730), which was published in August, 1954 (App. 9a). Thus the Binder reference was published after the date of petitioner's invention but more than one year before his patent application.

The Examiner either rejected or refused to allow all of the claims of the application and the Board of Appeals affirmed (App. 65a–70a; 71a–73a). On petitioner's appeal to the Court of Customs and Patent Appeals, the decision of the Board of Appeals as to seven of the claims was reversed but the rejection of ten of the claims was affirmed "because the [petitioner] has lost his right to these claims" (App. 26a). With regard to these claims, the court ruled that while the Binder reference did not contain

[2] The subject matter to which the application relates is a new kind of synthetic rubber (Pet. 4). None of the details of the application are relevant to the questions raised by the petition.

an identical disclosure of petitioner's invention (App. 13a), the invention had become "obvious to the public at the time of the Binder publication" such that, under Section 103 of the Patent Act (35 U.S.C. 103), there would not have been a patentable invention had the Binder publication preceded the invention (App. 23a). The court therefore applied the time-bar provision of Section 102(b) of the Act (35 U.S.C. 102(b)) which provides that the right to a patent is lost if the invention "was patented or described in a printed publication * * * more than one year prior to the date of application for patent * * *."

ARGUMENT

The decision of the Court of Customs and Patent Appeals is correct and fully effectuates the purpose of Section 102(b). There is no conflict with the decisions of any other court. There is therefore no occasion for review by this Court.

1. Before considering the issues raised in the petition, we note that there is currently pending before this Court the issue of whether certiorari jurisdiction exists under 28 U.S.C. 1256 to review decisions of the Court of Customs and Patent Appeals in cases on appeal from the Board of Appeals of the Patent Office. *Brenner* v. *Manson*, No. 58, October Term, 1965. While we suggest in that case that jurisdiction does exist, we submit that, should the Court agree with petitioner that the issues raised in the petition call for this Court's review, disposition of the petition should nevertheless be held in abeyance pending a decision on the jurisdictional issue in *Manson*. If, on the other hand, the Court

believes, as we urge, that review of the decision below is unwarranted, then the petition should be denied.

2. Section 102(b) of the Patent Act (35 U.S.C. 102(b)) deals with the loss of right to a patent through events subsequent to invention where the application for patent is delayed. It provides that the right to a patent shall be lost if "the invention was patented or described in a printed publication * * * or in public use * * * more than one year prior to the date of the application for patent in the United States * * *." In one form or another, this provision has been part of the patent law since 1897.[3] Prior to 1939 the statutory bar applied if the subsequent publication appeared within two years of the date of the patent application; in 1939 the period was reduced to one year, thus increasing the scope of the bar.[4]

Petitioner concedes that the time bar applies if the disclosure prior to the patent application is of the *identical* invention contained in the patent, but argues that the bar does not apply where the disclosure merely renders the application "obvious" to one "skill[ed] in the art" within the meaning of section 103 of the Act (35 U.S.C. 103), which precludes patents on such obvious developments.

As the court below recognized, however (and as petitioner argued in that court), "Section 102(b) from its earliest beginnings has been and was intended to be directed toward the encouragement of *diligence* in the filing of patent applications and the protection of the public from monopolies on subject matter

[3] Rev. Stat. § 4886 (1878), as amended, Act of March 3, 1897, ch. 391, § 1, 29 Stat. 692.

[4] Act of August 5, 1939, ch. 450, § 1, 53 Stat. 1212.

which had already been fully disclosed to it" (App. 17a) (emphasis in original). It follows that it makes no difference whether the public disclosure prior to the patent application is of the precise invention disclosed in the application, so as totally to destroy the novelty of the application under the standard of Section 101 of the Act (35 U.S.C. 101), or is such that, in light of the knowledge of those skilled in the art, it renders the application obvious and hence unpatentable under the test of Section 103. In either case the reasons for the time-bar apply: Through a lack of the applicant's diligence the invention has fallen below the substantive standards of patentability more than one year before the application. Petitioner offers no argument showing how the decision below was thus not fully in accord with the purpose of the time-bar provision.

The result reached below is also supported by the history of the Act. In reaching its decision, the court below found that under the law prior to the Patent Act of 1952 the statutory time-bar had been the basis for rejecting or invalidating patents not only on the ground that a reference fully disclosed all the details of the invention (*i.e.*, there was an "anticipation"), but also because, in light of the reference, there was "no invention," (*i.e.*, the invention was "obvious" to one "skill[ed] in the art" under the judicial doctrine which was the predecessor of Section 103)[8] (App. 19a–21a). In view of the fact that the Patent Act of 1952 was intended to make no substantive changes in either the time-bar provisions of the law (Pet. 16–17) or the substantive standard of patenta-

[8] See *Hall* v. *Macneale*, 107 U.S. 90, 96; *Smith & Griggs Mfg. Co.* v. *Sprague*, 123 U.S. 249.

bility (H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952); S. Rep. No. 1979, 82d Cong., 2d Sess., p. 6 (1952)) the court properly concluded that the time-bar provision continues to apply in "obviousness" or "no invention" situations as well as in situations of exact "anticipation."

Nor does the result below conflict with the language of the 1952 Act. Section 103 was enacted to codify the prior judicial doctrine, originating in *Hotchkiss* v. *Greenwood,* 11 How. 248, that an invention is unpatentable if obvious to those skilled in the art. As such it naturally describes the requirements for patentability at the time of invention (as does Section 102(a), the other principal provision describing the novelty requirement of a patentable invention). Section 102(b), on the other hand, has reference to the consequences of a delayed application and hence speaks in reference to the time of the filing of the application. The question of statutory construction is whether an invention is "patented or described" within the meaning of Section 102(b) when it is rendered obvious to one skilled in the art before the delayed application, as well as when it is exactly disclosed. As we have shown, the purpose and history of Section 102(b) clearly indicate that the test of Section 103 was thus incorporated in Section 102(b).[6]

3. There is no conflict with *Bros Inc.* v. *Browning Mfg. Co.,* 317 F. 2d 413 (C.A. 8), as urged by petitioner (Pet. 22–23). The Court of Appeals for the

[6] Petitioner argues (Pet. 21–22) that the construction below would make Section 103 redundant, since if the obviousness test is incorporated in Section 102(b) it must also be incorporated in Section 102(a), where the identical "patented or described" language is used as the touchstone of novelty. Hence petitioner argues that, under the construction below, Section 103 would not

Eighth Circuit fully agreed that Section 103 was not intended to modify or affect the Section 102(b) time bar. There, as here, the argument was advanced that for a subsequent description of an invention to invalidate a patent under Section 102(b), the invention must be identically disclosed or described. There as here the argument was rejected. 317 F. 2d at 417.[7]

4. Finally, petitioner urges that the court below deprived him of procedural due process by relying upon Section 102(b) rather than exclusively upon Section 103 (Pet. 35–40). However, 35 U.S.C. 132 requires only the reasons for rejection of an application—not the precise section or sections of the statute relied upon. The court below found the statements of rejection by the Patent Office sufficient to warrant consideration of both a Section 103 and a Section 102(b) rejection (App. 11a). Petitioner clearly knew that the rejection was based upon a time bar and he asserts no actual prejudice.

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limit the standard of patentability beyond the limitation already incorporated in Section 102(a). To a large extent, however, Section 103 *is* thus substantively redundant. It was enacted to codify the judicial doctrine of obviousness which had been held to be implicit in the statute (in the absence of Section 103) since 1850, and thereby to achieve "uniformity and definiteness" and to "have a stabilizing effect." See H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7 (1952). Whatever substantive change was accomplished by Section 103 was designed to eliminate more restrictive tests of invention, inconsistent with the original 1850 test, which may have been assimilated into the law in the years shortly before 1952. See our Brief in No. 55, O.T. 1965, *United States* v. *Adams*, pp. 25–36. It is therefore no obstacle to the construction adopted below that it assumes that the standard of patentable invention would not be more restrictive if the Act contained only Section 102(a) and not Section 103.

[7] Petitioner's contention that a conflict exists in the decisions of the court below (Pet. 28–34) is relevant only as to decisions

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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AUGUST 1965.

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subsequent to that in the instant case. Petitioner refers to four such decisions: *Application of Ruschig*, 343 F. 2d 965 (April 22, 1965); *Application of Folkers*, 344 F. 2d 967 (May 13, 1965); *Application of Hughes*, 345 F. 2d 184 (May 20, 1965); *Application of Hassler*, decided July 1, 1965 (App. 49a–64a). Petitioner himself concedes that *Folkers* (Pet. 28) and *Hassler* (Pet. 29) follow and reaffirm the principles of the decision in this case, thus relying only upon *Ruschig* and *Hughes* to demonstrate the present existence of a conflict. In *Ruschig*, however, the court held that the rejection could not be sustained on either the ground of an "anticipation" or on that of "obviousness" so that the issue involved here was not reached. *Hughes* similarly did not decide the issue: The court there showed no concern with the date of invention, the date of filing, or the effective date of the reference relied upon, thus demonstrating the irrelevance to the decision of the time-bar provision of Section 102(b).

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

IN THE MATTER
of the
APPLICATION OF FREDERICK C. FOSTER,
Petitioner

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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IN THE MATTER
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APPLICATION OF FREDERICK C. FOSTER,
Petitioner

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I. INTRODUCTION

The Court of Customs and Patent Appeals, since its inception, has enjoyed unique freedom from guidance by this Court on patent matters.[1]

This petition and the decision on which it rests demonstrate *prima facie* the alarming consequences of the de-

[1] The first case from the Court of Customs and Patent Appeals involving patent issues ever accepted by this Court is No. 58 this term, *Brenner v. Manson* (Br. 5).

There can be no legitimate doubt concerning the existence of certiorari jurisdiction in this case under 28 U.S.C. 1256. Respondent properly suggests "that jurisdiction does exist" (Br. 5). The Respondent in No. 58 does not dispute the existence of jurisdiction over a petition filed in this Court by the patent *applicant*.

In view of the nature and importance of the issues presented by this petition, it is respectfully suggested, if review is granted, that disposition on the merits should be generally concurrent with the other pending cases involving section 103.

velopment of this essentially autonomous authority within the patent system.[2] The court below today is hopelessly and irreconcilably locked in internal conflict (Pet. 28-34).[3] By its decision in this case, such court has placed itself at odds with virtually every relevant decision of this Court (Pet. 21-28). In defiance of both precedent and the controlling statutes — and even of its own jurisdictional limits — it has set itself up as an arbiter of "policy" whereby its decisions ignore the requirements of procedural due process (Pet. 35-40) to give effect to prevailing notions of its own majority concerning what the patent laws *should* say rather than what they *do* say — and in the process it has rendered 35 U.S.C. 103, one of the "major changes or innovations" (Pet. 18) in the 1952 Act, an admitted redundancy (Br. 8-9, Note 6) in view of the recodification in section 102 of the antecedent statutory law (R.S. 4886) (Pet. 21-23).

II. THE DECISION BELOW IS INCONSISTENT WITH THE LEGISLATIVE HISTORY AND PURPOSE OF BOTH SECTION 102 AND SECTION 103

Respondent asserts that "The result reached below is also supported by the history of the Act" (Br. 7).

The admitted redundancy (Br. 8-9, Note 6) of sections 102(a) and (b) with section 103, implicit in the decision below, is flatly inconsistent with the legislative history of both statutes.

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[2] This situation is aggravated by the circumstance that the Patent Office follows and applies the decisions of the Court of Customs and Patent Appeals in preference to those of any other court.

[3] "Pet." refers to the Petition. "Br." refers to the "Brief of the Commissioner in Opposition" to the Petition. "App." refers to the Appendix filed separately with the Petition.

Emphasis appearing in the quotations in the brief is all added emphasis unless otherwise indicated.

35 U.S.C. 102(a) and (b) are a *recodification*, without change, of the pertinent paragraphs of the *old statute*, R.S. 4886 (Pet. 16-17).

Section 103 is a *new* statute codifying *decisional* law (Pet. 18).

If its substance had been implicit in the portion of R.S. 4886 now recodified in sections 102(a) and (b), as the opinion below (App. 19a) and Respondent (Br. 8-9, Note 6) urge, there would have been no reason for section 103. Far from being a "new statute" constituting one of the two acknowledged "major changes or innovations" in the 1952 Patent Act, it would have been an exercise in Congressional futility (Pet. 16-20).[4]

35 U.S.C. 102(b), which recodified a part of R.S. 4886, is concerned with *novelty*.

The *new* section 103 is *not* concerned with *novelty* but, as the title to that statute states, with "nonobvious subject matter".

These *separate* "novelty" and "obviousness" statutes foreclose patentability on mutually exclusive grounds. Section 102 is concerned *solely* with printed publications in which the invention is "described". Section 103 is concerned *solely* with printed publications (and other forms of prior

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[4] The court below was forced to find that the antecedent statute R. S. 4886 contemplated obviousness situations in view of the unqualified and repeated statements in the legislative history that the intent of Congress in the enactment of section 102(b) was merely to recodify the prior act without change (Pet. 16-17). Respondent, faced with the same dilemma, makes the same argument — and with equal lack of authority (Br. 8-9, Note 6).

Hall v. MacNeale, 107 U.S. 90, 96, and *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (Br. 7, Note 5) are inapposite. The result reached in both of these cases rests upon the finding that "the invention" had been in public use for more than two years prior to the date of the application for patent.

art) in which "the invention is *not . . . described as set forth in section 102*".

This *express* distinction between the "novelty" and "obviousness" statutes, *obliterated by the decision below,* is consistent with and required by the antecedent law which the statutes codified.

The ensuing table delineates the *separate* development of the requirements for novelty and unobviousness beginning with the Patent Act of 1836. As the table clearly reflects, the distinction expressed on the face of sections 102 and 103 has been observed throughout the years.

The table demonstrates that "the time-bar provisions" were never, prior to the decision in this case, applied to "obviousness" situations. Prior to the decision below, obviousness was always determined as of the "time the invention was made," just as now required by 35 U.S.C. 103.

The emasculation of section 103 for the alleged reason that it fails to serve the "purpose" of the totally distinct novelty statute (Br. 7) "with which section 103 per se has nothing whatever to do" (App. 22a) cannot be justified.

PRINTED PUBLICATIONS

AS DEFENSES BASED ON LACK OF NOVELTY	AS DEFENSES BASED ON OBVIOUSNESS
1836-1870	**1836-1870**
Act of July 4, 1836 (Section 5) provided that subject matter, to be patentable, must have been "not known or used by others before [the patentee's] discovery or invention thereof."	From 1836 to 1850 the lower courts invalidated patents on the ground that they constituted "no invention" or would have been "obvious to one of ordinary skill in the art" at the time the in-

vention was made. See for example, the decisions cited in the argument of counsel for Greenwood in *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 13 L. Ed. 683, 688-689 (1850). A further example appears in Mr. Justice Nelson's majority opinion in the same case where he presided in the District of Connecticut concerning an alleged "improvement in manufacturing buttons." The principle was ratified by the Supreme Court in *Hotchkiss v. Greenwood, supra.* From that date onward, this judicial doctrine was continuously and consistently applied to negate patentability of subject matter "obvious to one of ordinary skill in the art . . . at the time the invention was made."

1870-1897

Act of 1870; pertinent section recodified without change in 1874 as R.S. 4886, which provided that subject matter to be patentable must not have been "*de-*

1870-1897

Judicial doctrine continued unchanged. The Supreme Court recognized "obviousness" as "*a valid defense not given by the statute*" and phrased the question invol-

scribed in any printed publication in this or any foreign country, before [the patentee's] invention or discovery thereof. . . ."

ved as "whether the thing patented amounts to a patentable invention", *Mahn v. Harwood,* 112 U.S. 354, 358, 28 L. Ed. 665, 667, 5 S. Ct. 174 (1884). ". . . Proof that there is no invention or discovery strikes at the root of the whole claim. The patent is based on an affirmative fact, of which this is a direct negative. It *needed no statute to aid or justify this defense. . . .*" *Reckendorfer v. Faber,* 92 U.S. 347, 354, 23 L. Ed. 719, 723 (1876).[5]

1897-1939

R.S. 4886, as amended, provided that the patented subject matter must not have been "described in any printed publication in this or any foreign country, before [the patentee's] invention or discovery thereof, or more than two years prior to his application. . . ."

1897-1939

The judicial doctrine continued unchanged. This Court continued to recognize that the relevant time was the time the invention was made. *Concrete Appliances Co. v. Gomery,* 269 U.S. 177, 180, 70 L. Ed. 222, 225, 46 S. Ct. 42 (1925), and other cases cited at Pet. 25.

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[5] Any implication in the Commissioner's Brief (Br. 8, 9 and Note 6) that "obviousness" was "implicit in the [novelty] statute" since 1850 is in the teeth of the Court's pronouncements in *Mahn* and *Reckendorfer.* It is also contrary to the plain language of sections 102(a) and (b) and 103 (Pet. 16-21).

1939-1952	1939-1952
R.S. 4886 amended to reduce the "two year" bar to "one year."	Judicial doctrine continued unchanged.
January 1, 1953 to Present R.S. 4886 recodified, without change, in pertinent portion, as 35 U.S.C. 102(a) and (b).	**January 1, 1953 to Present** Judicial doctrine, unchanged, codified as 35 U.S.C. 103.
"Paragraphs (a) [and] (b) are based on . . . R.S. 4886 . . . "No change is made in these paragraphs other than that due to division into lettered paragraphs." Reviser's Note, 35 U.S.C. 102.	"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but *only by reason of decisions of the courts. . . .*" Senate Report No. 1979, 82nd Congress, 2nd Session, page 6; House Report No. 1923, 82nd Congress, 2nd Session, page 7.
"Section 102 in paragraphs (a), (b), . . . *repeats the conditions in the existing law relating to* novelty." Senate Report No. 1979, p. 5.	"The question of patentable invention depends upon the prior art existing at the invention date of the patent in suit. . . ." *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148, 155 (2 Cir. 1956).

III. THE DECISION BELOW CANNOT BE JUSTIFIED ON "POLICY" GROUNDS

Respondent's argument that the decision below which overturns a century of settled law to merge sections 102(a) and (b) with section 103 is justifiable on "policy" grounds overlooks the overweening policy which requires the courts to apply statutes *as enacted by the Congress.* The result below conflicts directly with the rules of statutory construction enunciated by this Court (Pet. 22). It conflicts as well with this Court's consistently expressed judgment that the patent statutes, including the "time-bar provisions" are to be construed in accordance with the express language of Congress (Pet. 26-28).[6]

IV. THE WORD "DESCRIBED" IN SECTIONS 102(a) AND (b) IS NOT SYNONYMOUS WITH "IDENTICAL DISCLOSURE"

Respondent and the court below seek to justify the emasculation of section 103 by a contrived interpretation of the word "described" in the novelty statute, section 102(b), to require that the "precise" (Br. 6) invention be

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[6] In addition to the cases cited in the petition, these cases include *Andrews v. Hovey,* 124 U.S. 694, 31 L. Ed. 557, 8 S. Ct. 676 (1888) and *Bate Refrigerating Co. v. Sulzberger,* 157 U.S. 1, 39 L. Ed. 601, 15 S. Ct. 508 (1895). In the latter case the Court, refusing to substitute the "policy of the government" for the words of the statute, held:

> "In our judgment the language used is so plain and unambiguous that a refusal to recognize its natural, obvious meaning would be justly regarded as indicating a purpose to change the law by judicial action based upon some supposed policy of Congress. . . .
>
> * * * * * *
>
> ". . . it is not for the courts to tamper with the words of a statute, or, by a strained construction of legislative enactments, the language of which is clear and explicit, to accomplish results not contemplated by Congress. . . ." [157 U.S. at 37-38; 39 L. Ed. at 611.]

"identically" (Br. 2, 6) or "exactly" (Br. 8) disclosed in a printed publication reference "so as to totally destroy the novelty" (Br. 7).

This is an artificial issue.[7] Neither Petitioner nor Respondent so contended below. No court has so held. It is inconsistent with the position taken by Respondent in its "Brief in No. 55, O.T. 1965, *United States v. Adams*" (Br. 9).[8] This spurious issue was invented below by the majority and it is relied upon here to support the argument that the lower court's "interpretation of section 102(b)" is essential to give that statute practical effect.

In the practical application of the novelty statutes, the courts have always recognized, as did the court in the conflicting opinion in *Bros Inc. v. Browning Mfg. Co.*, 317 F. 2d 413 (8 Cir. 1963),[9] that an "invention" was "de-

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[7] The issue is wholly artificial because neither the Patent Office nor the Solicitor in his argument before the court below ever asserted that Binder "described" Petitioner's claimed invention, "identically" or otherwise. Rather, the rejection below rested upon a recognition that the Binder reference, if available at all, could only be available under section 103 because it *neither* "identically disclosed" nor "described" Petitioner's "invention" (Pet. 6, 17).

[8] In its brief in *Adams,* Respondent properly argues that section 102 is not limited to printed publications in which "the invention" is "identically disclosed". In that brief, Respondent states:

> ". . . In effect, as the tables in a 1929 treatise exemplify . . . , the art knew of a finite, interchangeable list of substances, all capable of functioning as electrodes in batteries with fluid electrolytes. Adams drew two substances from this limited list and combined them in the very way in which the list indicated they could be combined. . . . It would denigrate any meaningful standard of novelty to hold that Adams' battery was therefore 'new.' . . . the only conclusion which can be drawn . . . is that Adams 'invention was known * * * by others' and, therefore, was not 'new' within the meaning of Sections 101 and 102 of the Act." (Brief for the United States, O.T. 1965, No. 55, pp. 17-18).

[9] The decision below conflicts in principle with the decision in *Bros Inc.* In *Bros Inc.* the court held that "section 103 is not

scribed", *in the absence of "identical disclosure"*, whenever the "description" in the printed publication was

> ". . . sufficient . . . to enable one skilled in the art of constructing . . . machinery to reproduce the invention without having resort to the patent" [317 F. 2d at 416].

This Court has frequently recognized the same rationale. For example, in *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1, 75 L. Ed. 801, 51 S. Ct. 328 (1931), a process for rendering fruit mold-resistant by dipping it in an aqueous solution of borax was recognized to be the same invention as, hence "described" by, a prior art process for rendering various edibles mold-resistant by dipping them in another boron-containing chemical — namely boracic acid. In invalidating the patent, this Court stated:

> ". . . It lacks *novelty*. The *substance* of its disclosures had been revealed by Bishop twenty years earlier" [283 U.S. at 14; 75 L. Ed. at 808].

The Court of Customs and Patent Appeals, both prior and subsequent to the decision in this case, has experienced no difficulty in giving practical effect to the novelty statute by the proper application of printed publications in which "the invention" is *not* "identically disclosed" — while, at the same time, recognizing that "there are *limitations* on the availability of disclosures in printed publications as bars under section 102(b)" [*Application of LeGrice*, 301 F. 2d 929, 943 (1962)]. *Application of Petering*, 301 F. 2d 676 (CCPA 1962); *Application of Sheppard*, 339 F. 2d 238 (CCPA 1964);[10] *Application of Ruschig*, 343 F. 2d 965

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intended to modify or affect the section 102(b) time bar". In *this* case, the court below held, in effect, that section 103 enlarges section 102(b) to include printed publications in which the invention is *not* "described" as section 102(b) expressly requires.

[10] A typical example is found in *Sheppard* in which Chief Judge Worley, recognizing that the doctrine of *LeGrice* applied equally to

(CCPA 1965); and *Application of Hughes*, 345 F. 2d 184 (CCPA 1965). *Cf. Application of Hassler*, 347 F. 2d 911 (CCPA 1965), Concurring opinion (App. 62a-64a).

V. THE FUNDAMENTAL CONFLICT IN THE COURT BELOW

Each of *LeGrice, Petering, Sheppard, Ruschig* and *Hughes, supra*, holds that while "identical" disclosure is of course not required, there is a *limitation* on the availability of disclosures in printed publications to defeat novelty under 35 U.S.C. 102(a) and (b) by which such references are distinguished from the larger class of printed publications competent only to show obviousness under 35 U.S.C. 103 (Pet. 28).

The decision below and the decisions in *Application of Folkers*, 344 F. 2d 967 (CCPA 1965) and *Application of Hassler*, 347 F. 2d 911 (CCPA 1965) hold exactly the contrary. Each of these cases stands for the proposition that printed publications in which "the invention" is "*not* . . . described" (35 U.S.C. 103) are, nevertheless, competent under the *novelty* statutes 102(a) and (b) which, in terms, are limited to "printed publications" in which the invention is "described."

This is a basic and fundamental conflict. It goes to the very heart of both of the statutes defining the "conditions

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section 102(a), reversed a rejection under that statute in the following language:

> ". . . The Emeleus article is not so particular and definite that, without undue experimentation, one versed in the art to which it pertains could gain possession of the claimed subject matter. Under the circumstances we feel obliged to reverse the rejection of claims 2 and 3 under 35 U.S.C. §102(a)" [339 F. 2d at 242].

Compare the failure of the Binder reference in this case to teach or suggest any procedure by which Petitioner's "new kind of synthetic rubber" (Br. 4) could be achieved.

for patentability." Its importance far transcends the mere interpretation of the time bar provisions of section 102(b) (Br. 9, Note 7).

Resolution of this basic conflict at this time is fundamental to the efficient administration of the court below and of the Patent Office which looks to it for guidance.

VI. SECTION 103 DID NOT LOWER THE STANDARD OF INVENTION

Respondent recognizes that ". . . under the construction below, Section 103 would not limit the standard of patentability beyond the [novelty] limitation already incorporated in Section 102(a)" (Br. 8-9, Note 6). To justify this constitutionally proscribed result, Respondent seems to imply that its own brief in No. 55 urges that Congress intended to lower the pre-existing "standard of invention" by the enactment of section 103. Petitioner does not understand the Brief of the United States in that case to so contend. Rather, the brief seems clearly to insist that the standard has not been changed — a conclusion which is indeed compelled by any thorough and unbiased examination of *authoritative* precedent, legislative history and the statute itself. A contrary expression from the United States would be in the teeth of the position taken in its Petition for Writ of Certiorari in No. 55.

VII. PROCEDURAL DUE PROCESS QUESTION TWO

Petitioner was *not* notified of the "reasons" for the "rejections" of his claims applied by the Court of Customs and Patent Appeals (Pet. 35-40).

The Patent Office Solicitor advanced *two separate* rejections based on *two separate* portions, "Disclosure A" and "Disclosure B", of the Binder reference. These rejections

were *separately* characterized as "The Rejection Under Section 103" based on "Disclosure A" and "The Rejection Under Section 102" based on "Disclosure B" (Pet. 6).

"The Rejection Under Section 102" based on "Disclosure B" was reversed (Pet. 6, App. 13a). It is not before this Court.

In rejecting Petitioner's claims on the very same "Disclosure A" which the Solicitor stated was "the basis of the rejection of the claims predicated on section 103" (Pet. 6), the majority below said:

> "We wish to make it clear that this rejection is predicated on our construction of section 102(b) . . . ". . . with which section 103 per se has nothing whatever to do" (App. 22a).[11]

The court's entry of this *new* rejection, of which Petitioner was never notified and to which Petitioner has never been afforded an opportunity for response, is not only an obvious violation of procedural due process under 35 U.S.C. 132.[12] It is an excess of the court's own statutory jurisdiction under 35 U.S.C. 144 (Pet. 37-39).

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[11] The suggestion in Respondent's brief that the court below "found the statements of rejection by the Patent Office sufficient to warrant consideration of both a Section 103 and a Section 102(b) rejection" (Br. 9) is a mere reiteration of the court's own self-serving attempted justification for its entry of a new rejection (Pet. 12-13, Note 10). It cannot change the facts that Petitioner was *neither* notified of, *nor* given any opportunity to respond to, the reasons for the rejection of his claims.

[12] The court below, in *Application of Hughes*, 345 F. 2d 184, 186 (1965), decided *after* this case, pointed out with respect to sections 102 and 103 that "the issues arising under the two sections may be vastly different, and may call for the production and introduction of quite different types of evidence" (Pet. 38). 35 U.S.C. 132 requires notice sufficient to apprise the applicant concerning "the issues" (*Cf.* Br. 9).

VIII. CONCLUSION

This Petition for Writ of Certiorari should be granted.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

In the Matter of the

APPLICATION OF FREDERICK C. FOSTER, *Petitioner*

PETITION FOR REHEARING

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PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

In the Matter of the

APPLICATION OF FREDERICK C. FOSTER, *Petitioner*

PETITION FOR REHEARING

Petitioner prays that this Court grant rehearing of its order of April 4, 1966 denying the petition for writ of certiorari, — U.S. —, 16 L. Ed. 2d —, and that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals in the above-entitled case as prayed for in the petition filed July 14, 1965 herein.

The Intervening Circumstances

The "intervening circumstances of substantial and controlling effect" (Rule 58) on which this petition for rehearing is predicated are:

(a) the February 21, 1966 decisions of this Court in *Graham* v. *John Deere Co.*, — U.S. —, 15

L. Ed. 2d 545, and *United States* v. *Adams,* — U.S. —, 15 L. Ed. 2d 572, with which the decision below is in conflict; and

(b) the August 31, 1965 decision of the Court of Appeals of the Sixth Circuit in *Felburn* v. *The New York Central Railroad Company,* 350 F. 2d 416, *cert. den.,* — U.S. —, 15 L. Ed. 2d 852 (1966), and the September 14, 1965 decision of the Court of Appeals of the Fifth Circuit in *Bros Incorporated* v. *W. E. Grace Manufacturing Company,* 351 F. 2d 208, *cert. den.,* — U.S. —, 15 L.Ed. 2d 852 (1966), with which the decision is also in conflict.

The Conflict With Graham and Adams

(1) *Graham* and *Adams* hold that novelty (35 U.S.C. 102(a) and (b)) and "nonobviousness" (35 U.S.C. 103) are "separate tests of patentability" (*United States* v. *Adams,* — U.S. —, 15 L. Ed. 2d 572, citing *Graham*). "Nonobviousness" under section 103 is to be determined "at the time the invention was made" as that statute in terms requires.

Speaking with respect to the separate nonobviousness test of section 103, *Graham* recognizes that:

> "The first sentence of this section is strongly reminiscent of the language in *Hotchkiss.* Both formulations place emphasis on the pertinent art existing *at the time the invention was made* . . ." 15 L. Ed. 2d 545, 554.*

In invalidating the Scoggin patent for failure to meet the "nonobviousness" test of section 103, the Court said:

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* Unless otherwise indicated, emphasis has been supplied.

> "... To us, the limited claims of the Scoggin patent are clearly evident from the prior art as it stood *at the time of invention.*" 15 L. Ed. 2d 545, 567.

In *Adams,* the Court, in sustaining the patent in suit, observed:

> "... We have seen that *at the time Adams perfected his invention* noted experts expressed disbelief in it...." 15 L. Ed. 2d 572, 580.

(2) In direct conflict with *Graham* and *Adams,* the decision below confuses the separate statutory tests of patentability to hold that "nonobviousness" under section 103 is to be determined *not* "at the time the invention was made" as that statute provides but, instead, as of "one year prior to the application for patent", the time limitation specified in the separate novelty statute, 35 U.S.C. 102(b).

This anomalous result was reached below by interpretation of the word "described" in section 102(b) to include printed publications in which "the invention is not ... described as set forth in section 102 ..." and with which section 103 exclusively is concerned.[1]

In short, as the dissenting judge below aptly observed, and as respondent concedes,[2] the decision below

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[1] The first sentence of section 103 states in pertinent part:

> "A patent may not be obtained though the invention is not ... described as set forth in section 102 of this title, if the differences ... would have been obvious at the time the invention was made ..."

[2] R. Br., p. 8, footnote 6.

"... destroys any meaningful differences that may have existed in the past between sections 102(a) and (b) and section 103 ...." (Pet. App. 38a)[3]

(3) The emasculation of section 103 is a subject of widespread concern to legal scholars whose writings emphasize the importance and legally untenable consequences of the decision below.

Typical statements include the following:

"*Foster* . . . has rendered section 103 a mere redundancy." "Section 103 Obviousness as a Time-bar Under Section 102 (b)", 44 N. Car. L. Rev. 208, 224 (1965).

"... section 103 ... becomes redundant ..." Note, 11 Vill. L. Rev. 184, 188 (1965).

". . . by adopting the construction that section 102(b) *includes* obviousness within the word 'describes,' (sic) resort to section 103 is unnecessary." Note, 34 Geo. Wash. L. Rev. 376, 380 (1965).

". . . Since it appears that there is no difference between the two tests [under 102(b) and 103], the need for resorting to section 103 . . . should be relatively rare. . . .

"Moreover, the expansion by the *Foster* court of the word 'describe' in section 102(b) to encom-

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[3] This conclusion is compelled even by a casual examination of the statute.

The word "described" must have the same meaning in both sections 102(a) and (b) since both sections spring from and recodify the *single* occurrence of that word in R. S. 4886.

Adopting the lower court construction of the word "described", section 102(a), *like section 103,* would provide that a patent shall not be granted if

"the invention was . . . described in a printed publication . . . *or became obvious* . . . before the invention thereof by the applicant. . . ."

> pass 'describe or make obvious', might suggest a similar expansion in section 102(a) . . . . and section 103 would be largely redundant. . . ." Note, 54 Georgetown Law Journal 720, 724. (1966)

See, generally, "Obviousness under Section 103", XLVII JPOS, No. 10, 811, 830 (1965); "Prior Art and Obviousness", XLVII JPOS, No. 2, 79 (1965).

The Conflict With Felburn and Bros

(1) The crux of the conflict between the decision below and the rulings of this Court in *Graham* and *Adams* lies in the unjustifiably broad interpretation by the Court of Customs and Patent Appeals of the word "described" in section 102(b).

This specific conflict unfortunately is only one aspect of the massive confusion in the lower courts with respect to the proper interpretation of the word "described" in the novelty statutes. This fundamental conflict is significantly evidenced by the contrary lines of authority which have developed since this petition was filed on the issue of whether the word "described" in section 102(b) is satisfied *only* by an identical disclosure in a single printed publication of the very invention claimed.

The decision below rejected such a construction of the word "described", stating:

> ". . . the *contention seems to be that 102(b) has no applicability where the invention is not completely disclosed in a single patent or publication* . . . we think this contention is unsound . . . " (Emphasis in original) (Pet. App. 18a).

To the same effect on this point is the prior decision in *Bros Incorporated* v. *Browning Manufacturing Co.*,

317 F. 2d 413 (8 Cir. 1963), *cert. den.* 375 U.S. 825, 11 L. Ed. 2d 58, 84 S. Ct. 67, *rehearing den.*, — U.S. —, 15 L. Ed. 2d 857 (1966). *Bros Inc.* was followed on the same point in *Dix-Seal Corporation* v. *New Haven Trap Rock Company,* 236 F. Supp. 914, 918 (D. Conn. 1964).

(2) The *conflicting* line of authority fundamentally rests upon two appellate decisions intervening between the filing and denial of the petition in this case.

In *Felburn* v. *The New York Central Railroad Company,* 350 F. 2d 416, 420-421,[4] decided August 31, 1965, the Sixth Circuit Court of Appeals held:

> "... there appears to be novelty in the ... assembly defined in claim ... when tested according to the provisions of section 102. That is to say, the inventions claimed in these claims are not 'identically disclosed' in the prior art of record. ..."

In *Bros Incorporated* v. *W. E. Grace Manufacturing Company,* 351 F. 2d 208,[5] decided September 14, 1965, the Court of Appeals for the Fifth Circuit effectively adopted the "identity" construction of the word "described" rejected by the Eighth Circuit in *Bros* v. *Browning, supra,* to sustain under section 102(b) the very patent which the Eighth Circuit invalidated under the same statute in view of the same printed publication reference.

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[4] *Cert. den.*, —— U.S. ——, 15 L.Ed.2d 852 (1966).

[5] *Cert. den.*, —— U.S. ——, 15 L.Ed.2d 852 (1966). On the same day leave to file a petition for rehearing from the denial of the petition for certiorari in the Eighth Circuit case, *Bros* v. *Browning, supra,* was also denied, —— U.S. ——, 15 L.Ed. 2d 857 (1966).

Prompt Resolution of the Conflicting Decisions Is Essential

The denial of the certiorari petition in this case will necessarily aggravate the confusion in the lower courts with respect to the interpretation of the word "described" in the novelty statute, section 102.

The Patent Office unquestionably will follow the decision below and continue to determine the question of obviousness under section 103 by reference to the time-bar provisions of the separate novelty statute, section 102, all in direct contradiction to the rulings of this Court in *Graham* and *Adams*.

The important questions of interpretation of the patent statutes raised by this petition eventually must be resolved by this Court. If the decisions in *Graham* and *Adams* are not to be enervated by the conflicting decision below, immediate review and clarification of the law is essential.

CONCLUSION

For the reasons stated, the April 4, 1966 order denying the petition for writ of certiorari should be vacated and the petition for writ of certiorari should be granted.

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CERTIFICATE OF COUNSEL

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the rules of this Court.

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